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Supreme Court, U.S.
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NO. _____

IN THE

Supreme Court of the United States

STAR ATHLETICA, L.L.C., *Petitioner*,

v

VARSITY BRANDS, INC., VARSITY SPIRIT CORPORATION, AND VARSITY SPIRIT FASHIONS & SUPPLIES, INC., *Respondents*.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Sixth Circuit

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Under the Copyright Act, a "useful article" such as a chair, a dress, or a uniform cannot be copyrighted. 17 U.S.C. § 101. The article's component features or elements cannot be copyrighted either, unless capable of being "identified separately from, and existing independently of, the utilitarian aspects of the article." *Id.* Circuit courts, the Copyright Office, and academics have proposed at least nine different tests to analyze this separability The Sixth Circuit rejected them all and created a tenth. The first question is:

> What is the appropriate test to determine when a feature of a useful article is protectable under § 101 of the Copyright Act?

2. The Copyright Act specifies that in any judicial proceeding, the certificate of a registration made before or within five years after first publication is prima facie evidence of the copyright's validity. 17 U.S.C. § 410(c). The effect is to re-order the burden of proof to require the infringement-action defendant to prove the copyright is invalid. Until now, no circuit has given additional judicial deference to a registration. But the Sixth Circuit determined that a copyright registration is entitled to *Skidmore* deference. See *Skidmore* v. *Swift & Co.*, 323 U.S. 134 (1944). The second question is:

> Whether, in determining a copyright registration's validity, a court should give any judicial deference in addition to the statutory deference articulated in 17 U.S.C. § 410(c).

PARTIES TO THE PROCEEDING AND CORPORATE DISCLOSURE

There are no parties to the proceedings other than those listed in the caption. Petitioner is Star Athletica, LLC. Respondents are Varsity Brands, Inc., Varsity Spirit Corporation, and Varsity Spirit Fashion & Supplies, Inc.

Petitioner Star Athletica, LLC, does not have a parent corporation, and no publicly traded corporation owns a 10% or greater interest in the company.

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JURISDICTION

The district court had federal-question jurisdiction under 28 U.S.C. § 1331, and the court of appeals had jurisdiction under 28 U.S.C. § 1291. The court of appeals filed its opinion on August 19, 2015. On September 16, 2005, petitioner timely filed a petition for rehearing and rehearing en banc. The Sixth Circuit denied the petition on October 7, 2015, App. 79a, but granted a stay on October 20, 2015. This Court's jurisdiction rests on 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

Section 101 of the Copyright Act of 1976, 17 U.S.C. § 101, states, in pertinent part:

> Except as otherwise provided in this title, as used in this title, the following terms and their variant forms mean the following:
>
> * * *
>
> "Pictorial, graphic, and sculptural works" include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; *the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.*
>
> * * *
>
> *A "useful article" is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information. An article that is normally a part of a useful article is considered a "useful article".* [Emphasis added.]

Section 102 of the Copyright Act, 17 U.S.C. § 102, states:

> **(a)** Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:
>
> * * *
>
> (5) pictorial, graphic, and sculptural works
>
> * * *
>
> **(b)** In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

Section 113 of the Copyright Act, 17 U.S.C. § 113, states, in pertinent part:

> **(b)** This title does not afford, to the owner of copyright in a work that portrays a useful article as such, any greater or lesser rights with respect to the making, distribution, or display of the useful article so portrayed than those afforded to such works under the law, whether title 17 or the common law or statutes of a State, in effect on December 31,

> 1977, as held applicable and construed by a court in an action brought under this title.

Section 410 of the Copyright Act, 17 U.S.C. § 410, states, in pertinent part:

> (c) In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate. The evidentiary weight to be accorded the certificate of a registration made thereafter shall be within the discretion of the court.

INTRODUCTION

This case involves the most vexing, unresolved question in copyright law: how to determine whether a feature of a useful article—such as a garment or piece of furniture—is conceptually separable from the article and thus protectable. The Fourth Circuit describes this exercise as a "metaphysical quandary." *Universal Furniture Int'l* v. *Collezione Europa, Inc.*, 618 F.3d 417, 434 (4th Cir. 2010). The dissenting panel member here noted the "law in this area is a mess" and urged this Court to "clarify copyright law with respect to garment design." App. 57a (McKeague, J., dissenting). And the Sixth Circuit panel majority—after observing that courts "have struggled mightily to formulate a test" for separability—rejected nine recognized approaches articulated by the Copyright Office, other courts, and academics and created a tenth. App. 24a–42a.

The panel majority's approach exacerbates a circuit split and defeats Congress's well-recognized denial of copyright protection to garment designs or uniforms, despite lobbying by the garment-design industry for more than a century. The majority held that respondent Varsity can assert copyright in the stripes, chevrons, and color blocks incorporated into a cheerleader uniform because these features are purely aesthetic. Other circuits hold that uniform designs and dress features are not eligible for copyright protection. *E.g.*, *Galiano* v. *Harrah's Operating Co.*, 416 F.3d 411, 417–22 (5th Cir. 2005) (casino uniforms); *Jovani Fashion, Ltd.* v. *Fiesta Fashions*, 500 F. App'x 42, 44–45 (2d Cir. 2012) (prom dresses). As a result, a garment's protectability now turns entirely on the circuit where the copyright action is litigated.

This circuit conflict has immense practical implications. Congress drew a clear line in the Copyright Act between copyrightable works of applied art and uncopyrightable works of industrial design: § 101 excludes "useful articles" (and any "article that is normally a part of a useful article") from the scope of pictorial, graphic, or sculptural works, ensuring such articles do not receive protection greater than what is available by patent. (Copyrights are easier to obtain and last 90 years or more, much longer than a 14-year design patent.) Now, industrial designers can claim copyright protection in the Sixth Circuit for pleats on tennis skirts, button patterns on golf shirts, and colored patches on rugby uniforms. In the $330 billion apparel industry, this Court's setting of "the standard analytical tests all courts use to determine copyrightability" would "lead to greater predictability when it comes to determining parties' rights and liabilities." Edward F. Maluf, *Why Creativity Needs IP Protection*, Apparel (Oct. 13, 2015).[1]

The Sixth Circuit compounded the problem—and created a new circuit split—when it also gave extra-statutory *Skidmore* deference to Varsity's copyright registrations. App. 15a–22a (citing *Skidmore* v. *Swift & Co.*, 323 U.S. 134 (1944)). The Copyright Act addresses the weight a court should give to a registration by allocating the burden of proof to the party seeking to challenge a registration's validity. 17 U.S.C. § 410(c). Until now, no circuit has given additional *Skidmore* deference to a mere registration. *E.g.*, *Carol Barnhart Inc.* v. *Economy Cover Corp.*, 773 F.2d 411, 414 (2d Cir. 1985).

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[1] Available at http://tinyurl.com/oqpu417.

Varsity's counsel has conceded that the Sixth Circuit's separability and deference holdings have "significant implications for the apparel industry." Bonnie Eslinger, *6th Circuit Leaves Cheerleader Uniform IP Protection in Place*, Law 360 (Oct. 7, 2015).[2] As commentators have noted, the Sixth Circuit's opinion left the entire "fashion industry floundering for protection of design rights" and represents "an example of judicial activism in an area ripe, over ripe," for clarification. Leonard N. Budow, *Copyright and Fashion Design Confusion: Let's Move to Tennessee* (Oct. 5, 2015).[3] Certiorari is warranted.

STATEMENT

The Copyright Act and "useful articles"

This case involves the protectability of "useful articles," such as garments, bicycle racks, or wheel covers. "A 'useful article' has an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." 17 U.S.C. § 101. An article that is "normally" part of a useful article is also considered a useful article. *Ibid.* Thus, the non-protectability of useful articles ordinarily extends to the article's component parts. *Ibid.* The Copyright Act does protect pictorial, graphic, and sculptural works. *Ibid.* But the design of a useful article does not qualify for this protection unless the design "incorporates pictorial, graphic, or sculptural works *that can be identified separately from and are capable of existing independently of*, the utilitarian aspects of the article." *Ibid.* (emphasis added).

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[2] Available at http://tinyurl.com/odrcj73.

[3] Available at http://tinyurl.com/ozqeyg6.

To appreciate how the Copyright Act differentiates between copyrightable materials (think books, movies, sculptures) and unprotectable industrial designs (garments, chairs, lamps), a brief history of copyright in the United States is helpful. This background helps explain why a lamp using Michelangelo's *David* as its base is protectable, see *Mazer* v. *Stein*, 347 U.S. 201 (1954), but industrial designs like modern street lights, no matter how aesthetically pleasing, are not, see *Esquire, Inc.* v. *Ringer*, 591 F.2d 796 (D.C. Cir. 1978).

Congress first exercised its constitutional power to enact copyright legislation in 1790 by protecting maps, charts, and books. Act of May 31, 1790, ch. 15, 1 Stat. 124. Congress extended protection to three-dimensional "fine arts" objects, such as statues and models, in 1870. Act of July 8, 1870, ch. 230, § 86, 16 Stat. 198, 212. And though the 1909 Copyright Act removed the phrase "fine arts," Act of Mar. 4, 1909, ch. 320, 35 Stat. 1077, it was well understood that U.S. copyright law did not protect garment design. Indeed, the garment-design industry was among the first to call for copyright protection of industrial designs, and a bill was introduced for this purpose in 1913. Statement of the Register of Copyrights, *Industrial Design Protection: Hearings on* H.R. 902, 3017, *and* 3499 *Before the Subcomm. on Courts, Intellectual Property & the Admin. of Justice of the H. Comm. on the Judiciary*, 101st Cong., 2d Sess., 436, 445–46 (1991) [hereinafter "1991 *Design Protection Hearings*"]. But this bill, and many others intended to protect the design of useful articles and introduced between 1914 and the early 1990s, were never enacted. *Id.* at 445–50.

Then, in the mid-1950s, this Court considered a copyright-infringement claim involving the copyright of a dancing figurine that formed the base for lamps. The Court's opinion in *Mazer* made clear that a manufacturer cannot circumvent a work's copyright simply by using the work in a useful object. 347 U.S. at 218–19. But the opinion said nothing about whether the lamp itself (or a coffee maker or wedding gown) could be copyrighted. Accordingly, the Copyright Office issued a regulation that accommodated the Court's holding in *Mazer* while continuing to exclude industrial design—the separability standard:

> If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will *not* qualify it as a work of art. However, if the shape of a utilitarian article incorporates features, such as artistic sculpture, carving, or pictorial representation, *which can be identified separately and are capable of existing independently as a work of art*, such features will be eligible for registration. [37 C.F.R. § 202.10(c) (1959) (revoked after implementation of the 1976 Copyright Act) (emphasis added).]

The *Mazer* decision has been interpreted to introduce the concept of separability, and to stand for the proposition that copyright can be claimed in artistic features of a useful article that are capable of separate and independent existence apart from the shape of the useful article. 1991 *Design Protection Hearings*, at 436, 448.

In 1961, the Copyright Office reaffirmed that useful articles should not be copyrighted. H. Comm. on the Judiciary, 87th Cong., 1st Sess., Copyright Law Revision, Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law 13 (Comm. Print 1961). As the Office explained, copyright protection for industrial design is problematic given the anticompetitive fallout of providing wide-ranging protection for commercial design and the staggering potential liability for distributors who innocently sell useful articles. *Ibid.*

The Copyright Office considered garments particularly ill-suited to copyright protection, and it opposed extending copyright protection to "wearing apparel." *Ibid.* A yard of dress material or a dress itself would not be accepted for deposit with the Copyright Office because they are useful articles. *Id.* at 14. Similarly, a copyright in a work that *displays* useful articles, like a picture of a dress, would not extend copyright protection against the manufacture of the dress itself. *Ibid.* See also, H. Comm. on the Judiciary, 89th Cong., 1st Sess., Copyright Law Revision, Supplementary Register's Report on the General Revision of the U.S. Copyright Law 47–48 (Comm. Print 1965).

Notwithstanding this advice, the U.S. Senate proposed as part of the 1976 Act design-protection legislation that, excluding "staple or commonplace" designs and those "dictated solely by a utilization function of the article," would protect the "original ornamental design of a useful article" for a maximum of 10 years. S. 22, Tit. II, 94th Cong., 1st Sess., §§ 201–35, 122 Cong. Rec. 3856–59 (1975), *reprinted in* S. Rep. No. 473, at 39–47 (1975). That proposal died in the House "because the new form of design

protection could not truly be considered copyright protection and therefore appropriately within the scope of copyright revision." H.R. Rep. No. 94-1476, at 50 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659. The House Report on the bill identified concern that such an extension of existing copyright law "would create a new monopoly which has not been justified by a showing that its benefits will outweigh the disadvantage of removing such designs from free public use." *Id.* The conference committee rejected the Senate's design-protection legislation. H.R. Rep. No. 94-1733, at 82 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5810. And the Copyright Office's administrative regulations were formally codified in § 101 of the Copyright Act of 1976. 17 U.S.C. § 101.

The 1976 Act did not change the longstanding rule that clothes cannot be copyrighted. *Whimsicality, Inc.* v. *Rubie's Costume Co.*, 891 F.2d 452, 455 (2d Cir. 1989). It remains well settled that garments are useful articles. *Fashion Originators' Guild of Am.* v. *Fed. Trade Comm'n*, 312 U.S. 457, 461 (1941); *Whimsicality*, 891 F.2d at 455. See also Kal Raustiala, Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 Va. L. Rev. 1687, 1697 (2006) (examining *Fashion Originators*). The Copyright Office agrees: "Garments are useful articles, and the designs of such garments are generally outside of the copyright law." Registrability of Costume Designs, 56 Fed. Reg. at 56,531. And the fashion industry has continued to lobby for design protection to no avail. See Statement of the Copyright Office, *Industrial Design Protection: Hearings on* H.R. 5055 *Before the Subcomm. on Courts, Intellectual Property & the Admin. of Justice of the H. Comm. on the Judiciary*, 109th Cong., 2d Sess. (2006).

As noted above, the Copyright Act does not extend copyright to useful articles, defined as those "having an intrinsic utilitarian function that is not *merely* to portray the appearance of the article or to convey information." 17 U.S.C. § 101 (emphasis added). While a useful article's subcomponent can sometimes be protected (think "The Spirit of Ecstasy" hood ornament on a Rolls-Royce), copyright normally extends only to those subcomponents capable of being "identified separately from, and existing independently of, the utilitarian aspects of the article." *Id.*

The judicial test for separability has proven to be elusive. Courts "have twisted themselves into knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be identified separately from and exist independently of the article's utilitarian function." *Masquerade Novelty, Inc.* v. *Unique Indus.*, 912 F.2d 663, 670 (3d Cir. 1990). The decision here adds to the confusion by adding a tenth separability test, reaches an outcome at odds with a century of established public policy against extending copyright protection to garment design, and calls for this Court's immediate clarification.

The parties and cheerleading-uniform designs

Respondent Varsity is the world's largest manufacturer and distributor of cheerleading and dance-team uniforms and accessories. As reported in *Fortune* magazine, "[n]early every uniform sold or camp attended by high school or college cheerleaders is part of Varsity's vast empire of pep." Colleen Leahey, *The business of cheer*, Fortune (Dec. 21,

2012).[4] To protect its cheer empire, Varsity sues new market entrants[5] or simply acquires its successful competitors.[6] The net result is inflated uniform prices, to the detriment of families everywhere. *E.g.*, Courtney Spradlin, *'Pay-to-play' cheerleading often cost prohibitive*, Shreveport Times (Feb. 20, 2015).[7]

Varsity employees design cheerleading uniforms with standard design elements, and it has registered hundreds of copyrights of two-dimensional drawings and photographs of uniforms. R.173, Varsity's Statement of Uncontested Material Facts § 34, Pg. ID 2384, 2393–94. Varsity's designers begin their process by sketching a design over an outline of a cheerleader. App. 60a. Not surprisingly, each design produced by Varsity's designers is of a cheerleading uniform, not an abstract form. *Ibid.*

The Copyright Office initially rejected many of Varsity's cheerleading-uniform designs. 11/10/08 Copyright letter. The Copyright Office noted that Varsity was seeking to copyright clothing which are useful articles and cannot be copyrighted. *Ibid.* The

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[4] Available at http://goo.gl/EaECwa.

[5] *E.g.*, *Varsity Brands, Inc.* v. *Teamleader.com*, No. 05-Civ.-2340 (W.D. Tenn. 2005) (copyright infringement); *Varsity Brands, Inc.* v. *J&M Spirit Wear, Inc.*, No. 09-cv-1795-PKC (S.D.N.Y. 2009) (same); *Varsity Brands, Inc.*, v. *Sills*, No. 1:2010cv01164 (W.D. Tenn. 2010) (same); *Varsity Brands, Inc.* v. *MSG Holdings, L.P.*, No. 1:2011cv08053 (S.D.N.Y. 2011) (trademark); *Varsity Spirit Corp.* v. *Cheer Etc.*, No. 1:2011cv08312 (S.D.N.Y. 2011) (same).

[6] http://goo.gl/okVUdJ (noting Varsity's November 2015 acquisition of JAM Brands).

[7] Available at http://goo.gl/JiD9KV.

Copyright Office explained that Varsity could seek patent protection for its industrial designs. *Id.* at 2. Varsity vociferously objected that it was not seeking to copyright clothing designs; Varsity claimed it was seeking to copyright the design of stripes, chevrons, and color blocks appearing "on" the cheerleading uniforms. 01/28/09 Recons. Letter 4–5. And Varsity argued that if there was any possibility that its cheerleading-uniform designs were copyrightable, the Copyright Office's reasonable-doubt policy required registration. 03/08/07 Recons. Letter 13. The Copyright Office ultimately capitulated and said that works Varsity deposited could be copyrighted, although the works were only minimally sufficient. 02/19/09 Copyright Office Recons. Letter.

Contrary to Varsity's arguments to the Copyright Office, Varsity's lead designer explained that stripes, chevrons, zigzags, and lines *are* all "basic elements" of cheerleading-uniform design. R.169-1, Ex. 43, Williams Dep. 166:20-22; R.176, Ex. U, Williams Dep. 62:2-8. This conclusion is logical, as "[m]ost cheerleading designs use diagonals, curves, lines and bright colors *to achieve the function of identifying the person wearing it as a cheerleader*" and as a particular team's member. R.169-2, Sarabia Decl. ¶¶ 9, 11, Pg. ID 2178–80 (emphasis added). These basic elements also provide an important function integral to the style lines of uniforms manufactured by the "cutting and sewing" method of manufacture. Cheerleader uniforms are commonly stitched such that seams are on the outside for a clean inside surface, facilitating fit, comfort, and performance. Gary Spencer, a Varsity vice president, concedes that braid on Varsity's uniforms have a functional purpose of covering seams. R.169-1, Ex. 44, Spencer Dep. 95:22-24.

Star Athletica attempts to enter the cheerleading uniform market.

Created in 2010, Star Athletica, LLC, is a new entrant in the cheerleading-uniform market. After Star published its first catalogue, Varsity immediately sued. Varsity alleged that Star's cheerleader uniforms infringed the copyright Varsity possessed in its two-dimensional cheerleader-uniform drawings and photos, as if such copyrights could protect against the very thing Varsity told the Copyright Office it was not seeking—protection against the shape, contour, cut, style, and fit of Star's cut-and-sew cheerleading-uniform designs. See 01/28/09 Recons. Letter 5.

District Court proceedings

To establish copyright infringement, Varsity must prove ownership of a valid copyright, and " 'copying of constituent elements of the work that are original.' " App. 62a (quoting *Feist Publ'ns, Inc.* v. *Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991)). The district court resolved the case on summary judgment, focusing on Varsity's allegations of infringement and the scope of its copyrights. The district court ruled that Varsity's copyrights in two-dimensional drawings and photographs could not be used to prohibit Star from manufacturing actual cheerleading uniforms.

The district court framed the issue in the case as whether "a cheerleading uniform can be conceived without any ornamentation or design, yet retain its utilitarian function as a cheerleading uniform?" App. 72a–73a. The court answered that a cheerleading uniform without stripes, patterns, and chevrons, is *not* a cheerleading uniform.

The court explained, "it is not possible to either physically or conceptually sever Varsity's designs from the utilitarian function of the resulting cheerleading uniforms . . . ." App. 75a. The function of a cheerleading uniform "is not merely to clothe the body; it is to clothe the body in a way that evokes the concept of cheerleading." App. 74a. The court explained that "a cheerleading uniform loses its utilitarian function as a cheerleading uniform when it lacks all design and is merely a blank canvas. . . [A] blank silhouette of a purported 'cheerleading uniform' without team colors, stripes, chevrons, and similar designs . . is not recognizable as a cheerleading uniform." *Ibid.*

The district court also rejected Varsity's contention that its cheerleading designs were conceived of independent of their function as cheerleading uniforms. The court noted that "[t]he design sketches are clearly of cheerleading uniforms, conceived as worn by cheerleaders. . It also appears to be true that the designers were at all times conceiving of and sketching various designs of cheerleading uniforms." App. 73a. This is no surprise, as the designers were employed to create designs for a cheerleading-uniform manufacturer.

Sixth Circuit proceedings

On appeal, the panel majority began by considering the level of deference to give to Varsity's copyright registration. Noting that § 410 of the Copyright Act places the burden of proof on the party claiming invalidity, App. 15a, the majority then considered whether the registrations should be given additional judicial deference: "*Chevron*, *Skidmore*, or none?" App. 16a.

After analyzing a variety of federal circuit cases giving some level of judicial deference in non-registration contexts, App. 16a–19a, the majority held "that the Copyright Office's determination that a design is protectable under the Copyright Act is entitled to *Skidmore* deference," App. 19a. But the majority failed to consider, much less defer to, the Copyright Office's reasoned policy that garments are not protectable. And it rejected, without any explanation, the Copyright Office's test for analyzing separability. App. 30a, 37a–38a. The panel majority then identified nine other separability tests, most of which had been adopted by other circuits. App. 30a–33a, The panel majority rejected all of these tests in favor of "[t]he Sixth Circuit Approach" of its own making. App. 37a–38a.

Having exacerbated the circuit conflict over separability analysis, the panel majority next adopted Varsity's narrow view of a cheerleading uniform's function: to "cover the body, wick away moisture, and withstand the rigors of athletic movements." App. 43a. The panel majority side-stepped the argument that stripes, chevrons, and the like (1) identify the wearer as a cheerleader, (2) are part of the overall shape, contour, cut, style, and fit of cheerleading uniforms, and (3) enhance structural stability and the attractiveness of the wearer. App. 43a–44a. The panel majority concluded that stripes, chevrons, and color blocks served *no* utilitarian function but rather only a decorative function, opening the door for Varsity to use its copyright in two-dimensional sketches and photographs to stop Star from making actual, three-dimensional cut-and-sew cheerleading uniforms. App. 45a–46a (rejecting the Second Circuit's conclusion in *Jovani* that a utilitarian function of clothing is decorative).

In dissent, Judge McKeague observed that stripes and chevrons serve the important function of "identify[ing] the wearer as a cheerleader." App. 53a. A plain white uniform "may be appropriate for a match at the All England Lawn Tennis Club, but not for a member of a cheerleading squad." *Ibid.* Citing the only two circuit decisions addressing separability in the context of garment design—the Second Circuit's decision in *Jovani* (prom dress) and the Fifth Circuit's decision in *Galiano* (casino uniform)—Judge McKeague rejected the panel majority's approach to utilitarian function: a "uniform at its core identifies its wearer as a member of a group. . . [T]he stripes, braids, and chevrons on a cheerleading uniform are integral to its identifying function." App. 54a.

Judge McKeague also rejected the claim that such a conclusion would "render nearly all artwork unprotectable." Artwork is not a "useful article" under § 101 and thus is protected. App. 54a. And after the majority's willingness to recognize copyright protection for items with utilitarian function, companies like Varsity are allowed "the protection of patent-like features without having to fulfill the rigorous standards for obtaining a design patent." App. 56a (quoting *Winfield Collection, Ltd.* v. *Gemmy Indus.*, 147 F. App'x 547, 550–52 (6th Cir. 2005)).

Judge McKeague concluded that this Court's further elucidation of copyright law is essential with respect to garment design. Without "much-needed clarification" in this area—which he described as "a mess"—"courts will continue to struggle and the business world will continue to be handicapped by the uncertainty of the law." App. 57a.

The Sixth Circuit denied rehearing en banc but stayed its order pending this petition's resolution.

REASONS FOR GRANTING THE PETITION

I. The petition should be granted to resolve the multi-circuit conflict regarding the appropriate test to apply when determining which features of a useful article can be copyrighted.

Ever since *Mazer* v. *Stein*, 347 U.S. 201 (1954), lower courts have wrestled to separate copyrightable features of useful articles. Cases addressing separability invariably comment on the difficulty of formulating a workable test to consistently determine when the pictorial, graphic, or sculptural features incorporated into the design of a useful article can be identified separately from the article itself. *E.g.*, *Pivot Point Int'l, Inc.* v. *Charlene Prods.*, 372 F.3d 913, 920–21 (7th Cir. 2004); *Masquerade Novelty, Inc.* v. *Unique Indus.*, 912 F.2d 663, 670 (3d Cir. 1990); App. 29a–30a. Yet the separability determination is key to ensuring that copyright law (with its less-stringent requirements and much-longer protection) does not subvert Congress's regime for design patents. This concern is heightened in the area of garment design, because Congress has refused for more than a century to enact legislation to provide intellectual-property protection for clothing.

In the Copyright Act, Congress sought "to draw as 'clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design" by restricting the definition of [pictorial, graphic, or] sculptural works eligible for copyright protection under 17 U.S.C. 102(a)(5)." *Masquerade Novelty*, 912 F.2d at 669–70 (quoting H.R. Rep. No. 94-1476, at 55, *reprinted in* 1976 U.S.C.C.A.N. 5659, 5668). Congress did so by limiting the availability of copyright protection for

articles that have "an intrinsic utilitarian function that is not merely to portray the appearance of the article or convey information," denominated "useful articles" by the Act. 17 U.S.C. § 101. Congress provided that copyrightable pictorial, graphic, and sculptural works include the design of useful articles "only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." *Id.* But Congress established a presumption against separability, providing that "[a]n article [like stripes or chevrons] that is normally a part of a useful article [like a cheerleader uniform] is considered a 'useful article'." *Id.*; Sprigman, *Piracy Paradox*, 92 Va. L. Rev. at 1748.

The difficulty in applying this standard has spawned at least nine different separability tests, to which the panel majority added a tenth. App. 37a–39a. The Sixth Circuit's application of its eponymous test created a circuit split on the copyrightability of garment design—protection Congress has repeatedly rejected.

This Court has not revisited separability in the sixty years since *Mazer*, and it has never addressed the issue as codified in the 1976 Copyright Act. The Court's immediate intervention is sorely needed to resolve the very mature circuit split and to ensure uniform national application of the nation's copyright laws.

A. There are now at least ten different separability tests.

The panel majority aptly summarizes the tests the Copyright Office, various courts, and academics have proposed or followed to determine conceptual separability:

> (1) **The Copyright Office's Approach:** "A pictorial, graphic, or sculptural feature satisfies [the conceptual-separability] requirement only if the artistic feature and the useful article could both exist side by side and be perceived as fully realized, separate works—one an artistic work and the other a useful article." COMPENDIUM [OF U.S. COPYRIGHT OFFICE PRACTICES] III § 924.2(B) [(2014)].
>
> (2) **The Primary–Subsidiary Approach:** A pictorial, graphic, or sculptural feature is conceptually separable if the artistic features of the design are "primary" to the "subsidiary utilitarian function." *Kieselstein-Cord* [v. *Accessories by Pearl, Inc.*], 632 F.2d [989,] 993 [(2d Cir. 1980)].
>
> (3) **The Objectively Necessary Approach:** A pictorial, graphic, or sculptural feature is conceptually separable if the artistic features of the design are not necessary to the performance of the utilitarian function of the article. *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411, 419 (2d Cir.1985).
>
> (4) **The Ordinary–Observer Approach:** A pictorial, graphic, or sculptural feature is conceptually separable if "the design creates in the mind of the ordinary[, reasonable]

observer two different concepts that are not inevitably entertained simultaneously." *Id.* at 422 (Newman, J., dissenting).

(5) **The Design–Process Approach:** A pictorial, graphic, or sculptural feature is conceptually separable if the "design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences." *Brandir* [*Int'l* v. *Cascade Pac. Lumber Co.*], 834 F.2d [1142,] 1145 [(2d Cir. 1987)]; see also *Pivot Point*, 372 F.3d at 930–31; Robert C. Denicola, [*Applied Art & Indus. Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707,] 741–45 [(1983)].

(6) **The Stand–Alone Approach:** A pictorial, graphic, or sculptural feature is conceptually separable if "the useful article's functionality remain[s] intact once the copyrightable material is separated." *Pivot Point*, 372 F.3d at 934 (Kanne, J., dissenting).

(7) **The Likelihood–of–Marketability Approach:** A pictorial, graphic, or sculptural feature is conceptually separable if " 'there is substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities.' " *Galiano v. Harrah's Operating Co.*, 416 F.3d 411, 419 (5th Cir. 2005) (quoting 1 NIMMER ON COPYRIGHT § 2.08[B][3]). [App. 30a–31a (footnotes omitted, omissions in original).]

See also *Chosun Int'l* v. *Crisha Creations, Ltd.*, 413 F.3d 324, 330 (2d Cir. 2005) (applying something like the ordinary-observer approach).

In addition to these judicial tests, the Sixth Circuit identified two academic approaches that have not been adopted by any federal appellate courts. App. 31a–33a (identifying the Patry approach and the subjective-objective approach (citing 2 PATRY ON COPYRIGHT §§ 3.145–46; Note, Barton R. Keyes, *Alive and Well: The (Still) Ongoing Debate Surrounding Conceptual Separability in American Copyright Law*, 69 OHIO ST. L.J. 109, 141 (2008)).[8]

The panel majority rejected all nine tests (failing to defer to the Copyright Office's approach), and created its own, incorporating elements from various other tests. The "Sixth Circuit Approach" requires courts to consider five questions:

> (1) Is the design a pictorial, graphic, or sculptural work?
>
> (2) If [so], is it a design of a useful article?
>
> (3) What are the utilitarian aspects of the useful article?

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[8] The Seventh Circuit has identified yet another test, the Goldstein approach: "the artistic features 'can stand alone as a work of art traditionally conceived, and the useful article in which it is embodied would be equally useful without it.' " *Pivot Point*, 372 F.3d at 923 (quoting 1 Paul Goldstein, *Copyright: Principles, Law & Practice* § 2.5.3, at 2:67 (1989)) (alteration in original).

> (4) Can the viewer of the design identify "pictorial, graphic, or sculptu..al features" "separately from . . the utilitarian aspects of the [useful] article[?]"
>
> (5) Can "the pictorial, graphic, or sculptural features" of the design of the useful article "exist[] independently of[] the utilitarian aspects of the [useful] article[?]" [App 37a–39a (quoting 17 U.S.C. § 101) (alterations within quotations were done by panel majority).]

The Sixth Circuit's Approach can be distilled to requiring courts to "define the work's function and then ask whether the claimed elements can be identified separately from, or exist independently of, that function." App. 53a (McKeague, J., dissenting). Thus, the Sixth Circuit Approach does little more than restate § 101's definitions and provides no guidance on how to consistently determine whether a pictorial, graphic, or sculptural feature is separable (*i.e.*, exists independently) from the design of a useful article.

The varying tests adopted by the Second, Fifth, and Seventh Circuits have the virtue of providing guidance for identifying separability, albeit by emphasizing different considerations to effectuate the statutory test. The Second Circuit's primary-subsidiary approach requires courts to consider whether pictorial, graphic, or sculptural work are subsidiary to a utilitarian function (like holding pants around the waist) or primarily serve an aesthetic function (like jewelry). *Kieselstein-Cord*, 632 F.2d at 993. That circuit's objectively necessary approach also focuses on the function of the work within the

useful article, but with emphasis on whether the aesthetic features of the work are necessary to the function of the useful article. *Carol Barnhart*, 773 F.2d at 419. The "*Poe*/Nimmer" approach[9] adopted by the Fifth Circuit shifts the focus from the function of the pictorial, graphic, or sculptural work to whether, at least with regard to garments, the work has actual or potential market value apart from the useful article into which the work is incorporated. *Galiano*, 416 F.3d at 420. The design-process approach focuses on neither the marketability of the work nor its function within the useful article, but instead considers whether artistic judgment was exercised independent of the functional aspects of the useful article. *Pivot Point*, 372 F.3d at 931.

All of these tests have been criticized. The Second Circuit's shifting jurisprudence demonstrates that court's dissatisfaction with any of its formulations. The Fifth Circuit praised the elegance of the design-process approach, but did not apply it because the court was concerned about inconsistent results. *Galiano*, 416 F.3d at 421. The Fifth Circuit acknowledged criticisms of the *Poe*/Nimmer approach, but adopted it because the court believed that, at least with regard to garments, the approach harmonized existing caselaw. *Ibid.* In dissent, Judge Kanne criticized the design-process approach because it "lacks a basis in the statute." *Pivot Point*, 372 F.3d at 932-33.

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[9] *Poe* is *Poe* v. *Missing Persons*, 745 F.2d 1238 (9th Cir. 1984).

There is much to commend a combination of the consideration of process, function, and demonstrated marketability as art. Where the process of creating pictorial, graphic, or sculptural features of the design of a useful article demonstrates that aesthetic considerations trump utilitarian function, the features are separable. This is perhaps best demonstrated where a market actually exists for the useful article as art. Likewise, the exercise of independent artistic license weighs in favor of a determination of separability. Conversely, copyright protection is not available for artistic features that are adapted to further the utilitarian function of the useful article. See *Brandir*, 834 F.2d at 1145. Ultimately, however, the need for a national standard—or at least a consistent national framework for decision—is preferable to the current muddle of tests. Indeed, given the esoteric nature of the subject, the Court may well conclude, as the Fifth Circuit did in *Galiano*, that "a sub-optimal prophylactic rule" is preferable "because it is more determinate than the theoretically superior but hopelessly subjective one." 416 F.3d at 421.

Sixty years after *Mazer*, and nearly 40 years after the 1976 Copyright Act, the circuits are hopelessly fractured on how to determine whether pictorial, graphic, or sculptural features of the design of a useful article are separable. The Court should grant the petition to provide national uniformity.

B. The result in this case demonstrates the "Sixth Circuit Approach" is inferior to the approaches of other circuits.

The choice of which test to apply is outcome determinative, as this case demonstrates. And the outcome in this case—protecting garment design contrary to long-standing congressional intent—demonstrates the inferiority of the Sixth Circuit's approach. Indeed, given § 101's directive that an "article that is normally a part of a useful article is considered a 'useful article,' " it is exceedingly odd to say that the stripes and chevrons which are normally part of any cheerleader uniform are themselves non-useful and therefore copyrightable.

1. The result here conflicts directly with decisions of the Second and Fifth Circuits applying other approaches to address garment-design copyrightability. Those cases concluded that the garment designs at issue—casino uniforms in *Galiano* and prom dresses in *Jovani*—were not copyrightable, consistent with Congress's longstanding policy. The new Sixth Circuit approach resulted in a different and unprecedented outcome.

In *Galiano*, the Fifth Circuit considered whether the copyright of two-dimensional sketches of casino uniforms prevented Harrah's casino from making actual uniforms based on those sketches. The court turned to the leading treatise on copyright law, which suggested that conceptual separability exists " 'where there is substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities.' " 416 F.3d at 419 (quoting 1 NIMMER ON COPYRIGHT § 2.08[B][3], at 2-101).

The court found Nimmer's approach consistent with the Ninth Circuit and Copyright Office treatments of garment designs. *Id.* at 420 (citing *Poe* v. *Missing Persons*, 745 F.2d 1238 (9th Cir. 1984); Registrability of Costume Designs, 56 Fed. Reg. 56,530). Because the likelihood-of-marketability standard is implicit in garment-design cases, the Fifth Circuit limited the scope of its adoption of the approach to garment designs. *Id.* at 421. Applying the Nimmer/*Poe* approach to the casino uniforms, the Fifth Circuit held that the very creative design of the uniforms' buttons, pleats, and collars was not separable because the designs are not marketable independent of their utilitarian function as casino uniforms. *Id.* at 421–22.

Applying the Nimmer/*Poe* approach to this case would require affirming the district court's judgment that Varsity's cheerleading-uniform designs are not copyrightable. Like the casino-uniform designs in *Galiano*, Varsity's cheerleading-uniform designs are not marketable apart from their utilitarian function as cheerleading uniforms.

The Second Circuit reached the same result as the Fifth Circuit when faced with a copyright claim by a dress designer for "the arrangement of decorative sequins and crystals on the dress bodice; horizontal satin ruching at the dress waist; and layers of tulle on the skirt." *Jovani*, 500 F. App'x at 44. The court noted that it is well-settled that articles of clothing are useful articles that are not protected by the Copyright Act. *Ibid.* The court applied the design-process approach to determine whether the sequins, crystals, satin ruching, and tulle were the result of artistic judgment independent of functional concerns. *Ibid.*

The court then rejected the dress designer's contention that because the arrangement of design elements rendered the dress more attractive, they were not intrinsic to the dress's function. *Id.* at 45. Rather, the decorative elements enhanced the dress's functionality as clothing for special occasions, and furthered the clothing's decorative function.[10] *Ibid.* Because the aesthetic and functional aspects of a prom dress are inseparable, the Second Circuit concluded that the dress designer did not have a plausible copyright claim. *Ibid.*

Here, the district court applied the design-process approach and concluded that "[a]rtistic judgment and design are undeniably important in this context, but they are not separable from the utilitarian function of the resulting garment." App. 74a. No matter how creative the placement of braid, chevrons, and color blocks, these decorative elements of cheerleading uniforms are intrinsically linked to the utilitarian function of cheerleading uniforms—identifying the wearer as a cheerleader, associating the wearer with a certain team, and enhancing the wearer's attractiveness. Thus, in the Second and Fifth Circuits, Varsity's claims for copyright protection would have been rejected.

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[10] The Second Circuit previously explained that "clothes are particularly unlikely to [be separable because] the very decorative elements that stand out [are] intrinsic to the decorative function of clothing." *Whimsicality, Inc.* v. *Rubie's Costume Co.*, 891 F.2d 452, 455 (2d Cir. 1989).

2. The inferiority of the Sixth Circuit's Approach is demonstrated by the conflict between its result here and Congress's century-long refusal to extend copyright protection to garment designs. As discussed above, since 1913, Congress has repeatedly considered and rejected bills that would have extended copyright or copyright-like protection to garment designs. And Congress specifically rejected extending copyright protection to garment designs when it enacted the Copyright Act of 1976. The Senate bill approving the new copyright law included a second title to address copyrighting industrial designs. The House rejected that approach. H.R. Rep. No. 94-1476, at 50 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659.

Designers and marketers have always understood—correctly—that garments are ineligible for copyright protection. Registrability of Costume Designs, 56 Fed. Reg. at 56,531 ("On this point the copyright law is reasonably clear. Garments are useful articles, and the designs of such garments are generally outside of the copyright law.") It is for that very reason garment designers have been seeking legislation to protect their designs for nearly a century. The solution for designers like Varsity is to convince Congress of the merits of providing protection to industrial designs; the courts have "no power to read into the present statutes provisions which are not now contained in them." *Jack Adelman, Inc.* v. *Sonners Gordon, Inc.*, 112 F. Supp. 187, 190 (S.D.N.Y. 1934).

The Sixth Circuit's ruling contradicts more than a century of deliberate congressional inaction that strongly signaled Congress's disinclination to extend copyright protection to garment designs. *Cf. Kimble* v. *Marvel Ent., LLC*, 135 S. Ct. 2401, 2409-10 (2015) (interpreting Congress's spurning of multiple opportunities to overrule this Court's decision in patent context as legislative acquiescence). Not only has Congress frequently refused to extend copyright protection to garment design, it explicitly endorsed caselaw that prohibited using a two-dimensional sketch or picture of a useful article to copyright the useful article itself. 17 U.S.C. § 113(b).

The panel decision here allows roundabout copyrighting of garment designs masquerading as separable decorative features, preventing competition and inviting new copyright claims for all manner of garments, from band uniforms to everyday apparel, based solely on the arrangement of stripes and color blocks. Varsity has candidly acknowledged that the Sixth Circuit's rationale could cover designs on other kinds of clothing, Jonathan Stempel, *Court says Y-E-S! to cheerleader uniform design copyrights* (Aug. 19, 2015),[11] and thus has "significant implications for the apparel industry," Bonnie Eslinger, *6th Circ. Leaves Cheerleader Uniform IP Protection in Place*, Law 360 (Oct. 7, 2015).[12] It also has implications for all other manner of industrial designs, from vehicles to furniture to three-dimensional printing.

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[11] Available at http://tinyurl.com/pzhe8vo.

[12] Available at http://tinyurl.com/odrcj73.

3. The outcome in this case is also inconsistent with Congress's express intent to preserve pre-1978 jurisprudence governing the scope of copyright protection for depictions of useful articles:

> This title does not afford, to the owner of a copyright in a work that portrays a useful article as such, any greater or less rights with respect to the making, distribution, or display of the useful article so portrayed than those afforded to such works under the law in effect on December 31, 1977, as held applicable and construed by a court in an action brought under this title. [17 U.S.C. § 113(b).]

Among the pre-1978 limits Congress preserved was that a copyright for a drawing or photograph of a dress does not extend to prevent the manufacture of the article depicted.[13] *Jack Adelman*, 112 F. Supp. at 190 (copyright in a drawing of a dress does not extend to making and selling a dress like one in the drawing). Accord *Russell* v. *Trimfit, Inc.*, 428 F. Supp. 91, 93–94 (E.D. Pa. 1977) (same for "toe socks"). Here, the Sixth Circuit did just what *Jack Adelman* rejected and what § 113(b) prohibits—it extended a copyright in a *picture* of a useful article to the useful article depicted.

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[13] This limitation has its roots in the Court's seminal decision in *Baker* v. *Seldon*, 101 U.S. 99 (1879), distinguishing between the manifestation of ideas and ideas themselves. Only the former can be copyrighted. *Id.* at 101–02. Congress codified this distinction in the Copyright Act. 17 U.S.C. § 102(b).

4. Finally, the Sixth Circuit's opinion is contrary to Copyright Office policy. The Copyright Office has consistently held in its reasoned policy statements that "articles of clothing and costumes are useful articles that ordinarily contain no artistic authorship separable from their overall utilitarian shape." Registrability of Costume Designs, 56 Fed. Reg. at 56,531. The Copyright Office specifically extended this general rule to uniforms, *id.*, a policy which the Sixth Circuit has now effectively overruled.

In sum, the Sixth Circuit's Approach exacerbates a widespread, mature circuit split, obtains an outcome in this case that directly conflicts with decisions by the Second and Fifth Circuits, usurps Congress's authority, and diverges from Copyright Office policy. This Court's review would greatly benefit consumers, the fashion and retail industries, and the bench and bar.

II. The petition should also be granted to resolve the confusion created by the Sixth Circuit's extra-statutory deference to the Copyright Office's decision to register a copyright.

Having rejected the Copyright Office's well-reasoned policy that garments cannot be copyrighted, the Sixth Circuit concurrently advocated deference to registrations that depart from such policy by holding "that the Copyright Office's determination that a design is protectable under the Copyright Act is entitled to *Skidmore* deference." App. 19a. The court so held even though § 410 already establishes the deference owed to the Copyright Office's decision to register a copyright. 17 U.S.C. § 410(c).

The Sixth Circuit's decision is unprecedented (likely because Congress has already determined the deference owed): no court has ever accorded *Skidmore* deference to the Copyright Office's decision to register a copyright. As the Second Circuit remarked in *Carol Barnhart*, the courts are "in as good a position as the Copyright Office to decide the issue" of copyrightability. 773 F.2d at 414

A copyright is presumptively valid if it is filed not less than five years after the work is first published. 17 U.S.C. § 410(c). This presumption of validity is not irrebuttable; it merely orders the burdens of proof. *Carol Barnhart*, 773 F.2d at 414 (quoting H.R. Rep. No. 94-1476 at 157, *reprinted in* 1976 U.S.C.C.A.N. 5659, 5773). In an infringement action, the presumption shifts to the defendant the burden of proving the registration's invalidity. *Masquerade Novelty, Inc.* v. *Unique Indus., Inc.*, 912 F.2d 663, 668 (3d Cir. 1990). This is done by demonstrating that the Copyright Office erred by registering the copyright. *Id.* at 669. Congress has thus determined the "deference" owed to the Copyright Office's registration decision.

Courts generally accord some deference to an agency determination. *United States* v. *Mead Corp.*, 533 U.S. 218, 228, 237–38 (2001); *Skidmore*, 323 U.S. at 140. But deferring to the Copyright Office in a case challenging the validity of a registration places more weight in favor of a registration's validity than Congress intended. Where Congress has expressly defined a copyright registration's effect in a legal proceeding regarding validity, courts should not accord even greater weight to the registration via some form of judicial deference to the decision.

None of the cases the Sixth Circuit panel majority cites, see App. 17a–19a, support giving *Skidmore* deference to the Copyright Office's decision to register a copyright. Various circuits appropriately give *Skidmore* deference to the Copyright Office's interpretation of the Copyright Act in the Compendium of U.S. Copyright Office Practices, the Copyright Office's forms, and the Office's rules. *Inhale, Inc.* v. *Starbuzz Tobacco, Inc.*, 755 F.3d 1038, 1041–42 n.2 (9th Cir. 2014); *Alaska Stock, LLC* v. *Houghton Mifflin Harcourt Pub. Co.*, 747 F.3d 673, 684–86 (9th Cir. 2014); *Bonneville Int'l Corp.* v. *Peters*, 347 F.3d 485, 486–87 (3d Cir. 2003); *Olem Shoe Corp.* v. *Washington Shoe Corp.*, 591 F. App'x 873, 882 (11th Cir. 2015). Courts have also correctly given deference to the Copyright Office's interpretative circulars and reports. *Morris* v. *Bus. Concepts, Inc.*, 283 F.3d 502, 505–06 (2d Cir. 2002); *Cartoon Network LP, LLLP* v. *CSC Holdings, Inc.*, 536 F.3d 121, 129 (2d Cir. 2008); *WPIX, Inc.* v. *ivi, Inc.*, 691 F.3d 275, 283–84 (2d Cir. 2012). That is because all of these represent the reasoned decisions of the Copyright Office, rather than the determination of a single registration specialist. See COMPENDIUM III § 206. Indeed, copyrights are registered without any determination as to whether the work is substantially similar to another work, and without any investigation of the truthfulness or accuracy of the factual representations made in the application (including the originality of the design). *Id.* §§ 602.4(C)–(D).

Some courts have even gone so far as to give some level of deference to the Copyright Office's decision to deny a registration (a decision that does not implicate § 410), or a longstanding Office practice

of denying a certain category of registrations. *Norris Indus., Inc.* v. *Int'l Tel. & Tel. Corp.*, 696 F.2d 918, 922 (11th Cir. 1983); *Southco, Inc.* v. *Kanebridge Corp.*, 390 F.2d 276, 286 & n.5 (3d Cir. 2004) (*en banc*). But until this case, no court had ever deferred to the Copyright Office's registration decision itself, because doing so elevates a registration's presumption of validity higher than Congress intended.

According *Skidmore* deference to a copyright registration is unnecessary, because courts are well suited "to consider how the copyright law applies to the articles under consideration." *Carol Barnhart*, 773 F.2d at 414. This is especially true in the context of a separability analysis, as here. When called on to recommend a statutory separability standard, the Copyright Office urged that Congress "should not alter the distinctions drawn . . . by existing court decisions." Register's Report on the General Revision of the U.S. Copyright Law 15 (1961). Later, the Copyright Office attempted to draft a statutory test, but ultimately recommended again that Congress defer to existing judicial decisions, including *Jack Adelman*. Supplementary Register's Report on the General Revision of the U.S. Copyright Law 48 (1965). And this was the approach that Congress ultimately adopted. 17 U.S.C. § 113(b) ("This title does not afford, to the owner of a copyright in a work that portrays a useful article as such, any greater or less rights than those afforded to such works under the law . . in effect on December 31, 1977, as held applicable and construed by a court in an action brought under this title.").

The panel majority suggests "the Copyright Office's expertise in identifying and thinking about the difference between art and function surpasses ours." (App. 22a.) But in reality, the Copyright Office's policy is to register a copyright "even though there is a reasonable doubt about the ultimate action which might be taken under the same circumstances by an appropriate court . ." COMPENDIUM II OF COPYRIGHT OFFICE PRACTICES § 108.07 (1984). Indeed, Varsity invoked that very policy to obtain registration here.

The panel majority's selective deference to the Copyright Office's registration was virtually dispositive on the question of protectability. See App. 22a ("Not only do the [Office's letters to Varsity] demonstrate that the Copyright Office has interpreted the Copyright Act consistently, they also demonstrate that the Copyright Office has grounded its decisions to register Varsity's designs in the text of the statute using sound legal reasoning."). And the majority's deference decision stands in stark contrast to that court's inexplicable refusal to defer to the Copyright Office's actual policy decisions. For example, the panel majority did not even consider, let alone defer to, the Copyright Office's general policy of "nonregistrability of garment designs [including] . . uniforms." Registrability of Costume Designs, 56 Fed. Reg. 56,530, 56,531 (Nov. 5, 1991). The panel majority also ignored the Copyright Office's reasoned guidelines prohibiting the consideration of whether the article at issue could have been designed differently to determine separability. COMPENDIUM III §§ 924.2(B)–(C). Contra App. 45a–46a ("not all cheerleading uniforms must look alike to be cheerleading uniforms").

And after reciting the Copyright Office's separability approach, the panel majority offered no explanation for failing to simply apply it. See App. 31a (citing COMPENDIUM III § 924.2(B)). Had the majority properly deferred to the Copyright Office's actual policies, it could not have upheld the validity of cheerleader-uniform design registration. The sketches and pictures Varsity submitted do not allow one to perceive "fully realized, separate works"—one only perceives cheerleading uniforms. Contra COMPENDIUM III § 924.2(B).

In sum, the Sixth Circuit panel majority's decision is at odds with the Copyright Act and provides greater protection to copyright holders in the Sixth Circuit than elsewhere in the country. The Court should grant the petition to curb the court of appeal's expansion of deference to the Copyright Office's decisions to register copyrights, to ensure national uniformity on this constitutional issue, and to restore federal-court authority "to exercise [ ] independent judgment in interpreting and expounding upon the laws." *Perez* v. *Mortgage Bankers Ass'n*, 135 S. Ct. 1199, 1217 (2015) (Thomas, J., concurring).

III. This case is of substantial importance and presents an ideal vehicle for resolving the questions presented.

The U.S. apparel market is the largest in the world, with a market value of more than $330 billion. Statistics & Facts on the Apparel Market in the U.S.[14] By overturning long-settled law that for more than a century Congress has repeatedly refused to change, the Sixth Circuit's decision has created new uncertainty in the industry. Manufacturers must now consider whether their designs are substantially similar to someone else's copyright image of a shirt, a skirt, or a pair of slacks. Retailers must now wonder if clothes they sell violate two-dimensional copyrights. Everyone must decide how to adjust their policies—and prices—to adapt to this new, substantial risk. This uncertainty is presumably why the Sixth Circuit panel stayed the mandate pending this Court's consideration of the petition.

The industry has taken note. As the *National Law Review* explained, "[w]hether a garment design is copyrightable or not may [now] turn on how the court chooses to define the function of the garment." Teri H.P. Nguyen, *Sixth Circuit Court Fashions Hybrid Approach to Determining Whether Garment Designs are Copyrightable* (Sept. 29, 2015).[15] The result leaves the entire "fashion industry floundering

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[14] Available at http://tinyurl.com/oh8h6hg. As a point of comparison, the U.S. movie picture and video market totaled only $80 billion in 2012 according to the U.S. Census Bureau. See generally http://www.census.gov/econ/census/.

[15] Available at http://tinyurl.com/p3v7ymg.

for protection of design rights,'" and represents, in the words of the *Fashion Law Blog*, "an example of judicial activism in an area ripe, over ripe," for clarification. Leonard N. Budow, *Copyright and Fashion Design Confusion: Let's Move to Tennessee* (Oct. 5, 2015).[16]

The solution is for this "Court to set the standard analytical tests all courts use to determine copyrightability." Edward F. Maluf, *Why Creativity Needs IP Protection*, Apparel (Oct. 13, 2015).[17] That development would "lead to greater predictability when it comes to determining parties' rights and liabilities." *Id.* In other words: "Additional guidance would sure be appreciated." Chad Rutkowski, *Drawing a Line in the Floor—Courts Are Struggling With the Overlap Between Design Patent and Copyright*, IP Intelligence (Oct. 12, 2015).[18]

This case is also an ideal vehicle to decide the two questions presented. The panel majority issued a thorough opinion over a vigorous dissent. The two issues presented require the Court to answer purely legal questions. The separability question in particular has percolated among the circuits for more than thirty years, with no coherent answer. And if the Court adopts a test consistent with the long-standing prohibition on copyrighting the garments depicted in sketches or pictures of garment and § 113(b), that holding will fully dispose of Varsity's claims.

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[16] Available at http://tinyurl.com/ozqeyg6.

[17] Available at http://tinyurl.com/oqpu417.

[18] Available at http://tinyurl.com/ouy3wql.

Finally, the issues presented are of sufficient legal and public importance that they should be resolved immediately, notwithstanding the case's interlocutory posture. Accord, *e.g.*, *Sebelius* v. *Hobby Lobby Stores, Inc.*, 134 S. Ct. 678 (2013) (granting interlocutory petition); *American Broadcasting Cos.* v. *Aereo, Inc.*, 134 S. Ct. 896 (2014) (same); *Fifth Third Bancorp* v. *Dudenhoeffer*, 134 S. Ct. 822 (2013) (same); *Halliburton Co.* v. *Erica P. John Fund, Inc.*, 134 S. Ct. 636 (2013) (same); *Michigan* v. *Bay Mills Indian Cmty.*, 133 S. Ct. 2850 (2013) (same). Given the disparate separability tests being applied in the various circuits, American commercial and artistic authors generally—and the garment-design industry in particular—require an immediate clarification of the law of separability to guide their conduct.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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UNITED STATES COURT OF APPEALS

FOR THE SIXTH CIRCUIT

VARSITY BRANDS, INC.; VARSITY SPIRIT CORPORATION; VARSITY SPIRIT FASHIONS & SUPPLIES, INC.,

Plaintiffs-Appellants,

v.

STAR ATHLETICA, LLC,

Defendant-Appellee.

No. 14-5237

Appeal from the United States District Court for the Western District of Tennessee at Memphis.
No. 2:10-cv-02508—Robert H. Cleland, District Judge.

Argued: April 24, 2015

Decided and Filed: August 19, 2015

Before: GUY, MOORE, and McKEAGUE, Circuit Judges.

COUNSEL

ARGUED: Grady M. Garrison, BAKER, DONELSON, BEARMAN, CALDWELL & BERKOWITZ, P.C., Memphis, Tennessee, for Appellant. Michael F. Rafferty, HARRIS SHELTON HANOVER WALSH, P.L.L.C., Memphis, Tennessee, for Appellee. **ON BRIEF:** Grady M. Garrison, Bradley E. Trammell, Adam S. Baldridge, Nicholas L. Vescovo, BAKER, DONELSON, BEARMAN, CALDWELL & BERKOWITZ, P.C., Memphis, Tennessee, for Appellant. Michael F. Rafferty, Steven M. Crosby, Theodore C. Anderson, HARRIS SHELTON HANOVER WALSH, P.L.L.C., Memphis, Tennessee, for Appellee.

MOORE, J., delivered the opinion of the court in which GUY, J., joined. McKEAGUE, J. (pp. 33–36), delivered a separate dissenting opinion.

OPINION

KAREN NELSON MOORE, Circuit Judge. Are cheerleading uniforms truly cheerleading uniforms without the stripes, chevrons, zigzags, and color blocks? That is the question that strikes at the heart of this appeal. Plaintiffs-Appellants Varsity Brands, Inc., Varsity Spirit Corporation, and Varsity Spirit Fashions & Supplies, Inc. (collectively "Varsity") have registered copyrights for multiple graphic designs that appear on the cheerleading uniforms and warm-ups they sell. Defendant-Appellee Star Athletica, LLC, also sells cheerleading gear bearing graphic designs that, according to Varsity, are substantially similar to the designs for which Varsity has valid copyrights. Star asserts that Varsity's copyrights are invalid because the designs at issue

are unprotectable "design[s] of . . . useful article[s]." 17 U.S.C. § 101 (2012). The district court concluded that a cheerleading uniform is not a cheerleading uniform without stripes, chevrons, zigzags, and color-blocks, and therefore Varsity's copyrights are invalid. Varsity now appeals, and we take up the question that has confounded courts and scholars: When can the "pictorial, graphic, or sculptural features" that are incorporated into "the design of a useful article" "be identified separately from, and [be] capable of existing independently of the utilitarian aspects of the article[?]" *Id.*

For the reasons we now explain, we **REVERSE** the district court's judgment and enter partial summary judgment for Varsity with respect to whether Varsity's designs are copyrightable pictorial, graphic, or sculptural works, and **REMAND** the case for further proceedings consistent with this opinion.

I. BACKGROUND

Varsity designs and manufactures apparel and accessories for use in cheerleading and other athletic activities. R. 170 at 1 (Joint Statement of Undisputed Facts ("JSUF") ¶ 1) (Page ID #2228). It employs designers who sketch design concepts consisting of "original combinations, positionings, and arrangements of elements which include V's (chevrons), lines, curves, stripes, angles, diagonals, inverted V's, coloring, and shapes . . . ." R. 173 at 2–3, 6 (Pls.' Statement of Undisputed Facts ("PSUF") ¶¶ 1, 4, 21 (Page ID #2385–86, 2389); R. 173-2 at 4–5 (Williams Decl. ¶ 8) (Page ID #2439–40). When creating these designs, the designers do not consider functionality of the uniform or the ease of producing a full-sized uniform that looks like the sketch. R. 173 at 2–3, 6 (PSUF ¶¶ 4–5, 21) (Page ID #2385–86, 2389); R. 173-

2 at 4–5 (Williams Decl. ¶ 8) (Page ID #2439–40). After a designer completes a sketch, Varsity decides whether to implement that design concept for cheerleading or other uniforms, or whether to abandon the design concept altogether. R. 173 at 4 (PSUF ¶¶ 11–12) (Page ID #2387). Once Varsity selects a design for production, the production crew re-creates the design using one of four methods to create a cheerleading uniform: "cutting and sewing panels of fabric and braid together"; sublimation;[1] embroidery; or screen printing. *Id.* at 8–9 (PSUF ¶ 28) (Page ID #2391–92). Varsity sells its merchandise by advertising in catalogs and online by inviting customers to choose a design concept among the many designs that Varsity offers, before selecting the shape, colors, and braiding for the uniform. R. 173-3 at 3–4 (Williams Dep. at 22–23) (Page ID #2449–50).

Varsity sought and received copyright registration for "two-dimensional artwork" for many of its designs, including the following designs, which are the subject of this lawsuit:

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[1] Sublimation is the process of printing the design directly onto fabric. The printer heats the ink and infuses it into the fabric while the ink is gaseous. Once the design is printed onto the fabric, the production team cuts the fabric in the shape of the design and sews the pieces together. R. 173-1 at 4 (Spencer Decl. ¶ 8) (Page ID #2412) ("After the paper and fabric are finished feeding through the machine, the large pieces of fabric have the designs on them which are then cut out and the outer edges are sewn together as a front and back of a garment."); *see also* R. 173 at 9 (PSUF ¶ 31) (Page ID #2392).

Design 078
Registration No. VA 1-417-427

Design 299B
Registration No. VA 1-319-226

Design 0815
Registration No. VA 1-675-905

Design 299A
Registration No. VA 1-319-228

Design 074
Registration No. VA 1-411-535

R. 1-15 at 2 (Compl. Ex. 15) (Page ID #48); R. 1-16 at 2–3 (Compl. Ex. 16) (Page ID #51–52); R. 1-17 at 2 (Compl. Ex. 17) (Page ID #54); R. 1-18 at 2 (Compl. Ex. 18) (Page ID #57); R. 51-1 at 2 (1st Am. Compl. Ex. 9) (Page ID #536).[2]

Star markets and sells uniforms and accessories for football, baseball, basketball, lacrosse, and cheerleading. R. 170 at 2 (JSUF ¶ 5) (Page ID #2229). Varsity filed this lawsuit after seeing Star's marketing materials and noticing that Star was advertising cheerleading uniforms that looked a lot like Varsity's five registered designs. *See* R. 1 at 3–4, 6–10 (Compl. ¶¶ 13–15, 27–53) (Page ID #3–4, 6–10). Varsity alleges five claims of copyright infringement for "selling[,] distributing, [and] advertising . . . goods bearing . . design[s] that [are] copied from and substantially similar to" five of Varsity's designs in violation of the Copyright Act, 17 U.S.C. § 101 *et seq.* *Id.* at 7–10 (Compl. ¶¶ 29, 36, 42, 49, 56) (Page ID #7–10). In addition, Varsity has asserted that Star violated Tennessee's laws against unfair competition, inducement of breach of contract, inducement of breach of fiduciary duty, and civil conspiracy.[3] *Id.* at

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[2] Varsity's original complaint alleged that Star infringed Varsity Design 034. *See* R. 1 at 4 (Compl. ¶ 14(e)). Varsity sought leave to amend the complaint in order to allege that Star had infringed Design 074, not Design 034, R. 48 at 1 (Unopposed Mot. to Amend Compl. ¶ 1) (Page ID #518), which the district court granted, R. 49 at 1 (Order Granting Unopposed Mot. to Amend Compl.) (Page ID #531). Varsity attached a copy of Design 074 and the certificate of registration for Design 074 to its First Amended Complaint. R. 51-1 at 2 (Amend. Ex. 9) (Page ID #536); R. 51-2 at 2–3 (Amend. Ex. 19) (Page ID #538–39).

[3] Varsity also alleged violations of the Lanham Act, 15 U.S.C. § 1125(a) (2012). The district court entered summary judgment

[Footnote continued on next page]

11–13 (Page ID #11–13). Star denied liability for all of Varsity's claims and asserted counterclaims, including a claim that Varsity made fraudulent representations to the Copyright Office. R. 58 at 1–18 (Answer) (Page ID #585–602).

At the close of the discovery period, both parties filed motions for summary judgment. Star argued that it was entitled to summary judgment on all of Varsity's claims. With respect to Varsity's copyright-infringement claims, Star argued that Varsity does not have a valid copyright in the five designs for two reasons: (1) Varsity's designs are for useful articles, which are not copyrightable; and (2) the pictorial, graphic, or sculptural elements of Varsity's designs were not physically or conceptually separable from the uniforms, making the designs ineligible for copyright protection. R. 168 at 2 (Def.'s Mot. for Summ. J.) (Page ID #2121). Varsity asserted a right to summary judgment, as well, arguing that its copyrights were valid because the designs were separable and non-functional, and that Star infringed those valid copyrights. R. 172 at 1–2 (Pls.' Mot. for Summ. J.) (Page ID #2300–01). Varsity also sought dismissal of Star's counterclaims. *Id.* In response to Varsity's motion for summary judgment, Star primarily focused on whether Varsity's designs were unprotectable useful articles, *see* R. 176-2 at 8–13 (Def.'s Combined Mem. of Law in Opp'n to Pl's Mot. for Summ. J. and

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[Footnote continued from previous page]
for Star with respect to the Lanham Act claim upon Star's motion, which Varsity did not oppose. R. 199 at 17 (D. Ct. Op. & Order Re Mot. for Summ. J.) (Page ID #4311); 172 at 2 (Pls.' Mot. for Summ. J.) (Page ID #2300–01). Nor does Varsity appeal the entry of judgment on that claim.

Reply in Supp. of Def.'s Mot. for Summ. J.) (Page ID #3282–87), but also argued that Varsity had not met its obligation "to prove which 'key elements' of its designs are original," *id.* at 14 (Page ID #3288). Varsity responded in its sur-reply to Star's claim that Varsity's designs were unoriginal. *See* R. 177 at 10–11 (Pl.'s Sur-Reply in Supp. of Mot. for Summ. J.) (Page ID #3371–72).

The district court entered summary judgment in Star's favor on the copyright claims, concluding that Varsity's designs were not copyrightable because the graphic elements of Varsity's designs are not physically or conceptually separable from the utilitarian function of a cheerleading uniform because the "colors, stripes, chevrons, and similar designs typically associated with sports in general, and cheerleading in particular" make the garment they appear on "recognizable as a cheerleading uniform." R. 199 at 15 (D. Ct. Op. & Order Re Mot. for Summ. J.) (Page ID #4309). In other words, the district court held that the aesthetic features of a cheerleading uniform merge with the functional purpose of the uniform. The district court did not address whether Varsity's designs were unoriginal, and therefore unprotectable. Without addressing the merits of the state-law claims, the district court dismissed them without prejudice on the basis that it had resolved all of Varsity's federal claims and declined to exercise supplemental jurisdiction. *Id.* at 17–18 (Page ID #4311–12) (citing 28 U.S.C. § 1367(c)(3) (2012) ("The district court[] may decline to exercise supplemental jurisdiction over a claim if the district court has dismissed all claims over which it has original jurisdiction.")).

This appeal followed. Varsity challenges the district court's entry of summary judgment on the issue of copyright infringement and dismissal of the state-law claims. Appellant Br. at 16–18. Because Varsity seeks a remand to the district court for further proceedings, it asks that we address the district court's ruling permitting Star's experts to testify about whether Varsity's designs are copyrightable, non-useful designs. *Id.* at 18.

II. COPYRIGHT INFRINGEMENT

We review the district court's grant of summary judgment de novo. *Jones v. Blige*, 558 F.3d 485, 490 (6th Cir. 2009). When reviewing an entry of summary judgment, we view the record in the light most favorable to, and draw all reasonable inferences in favor of, the nonmoving party. *Id.* The moving party is entitled to summary judgment if "there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a).

Varsity has alleged that Star infringed its valid copyrights. To prevail, Varsity must show that (1) it owned a valid copyright in the designs, and (2) that Star "copied protectable elements of the work." *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 534 (6th Cir. 2004). We have said that "[t]he first prong tests the originality and non-functionality of the work," *id.*, but there are actually five elements to establish the validity of a copyright:

> (1) originality in the author; (2) copyrightability of the subject matter; (3) a national point of attachment of the work, such as to permit a claim of copyright; (4) compliance with applicable statutory formalities; and

> (5) (if the plaintiff is not the author) a transfer of rights or other relationship between the author and the plaintiff so as to constitute the plaintiff as the valid copyright claimant.

4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.01[A] (2003) (footnotes omitted). We have also said, "[t]he second prong tests whether any copying occurred (a factual matter) and whether the portions of the work copied were entitled to copyright protection (a legal matter)." *Lexmark*, 387 F.3d at 534. This means that "a court should first identify and eliminate those elements that are unoriginal [or not copyrightable] and therefore unprotected" "before comparing similarities between" the plaintiff's and defendant's works. *Kohus v. Mariol*, 328 F.3d 848, 853 (6th Cir. 2003). If the elements of the work that the defendant copied as a factual matter were not copyrightable—that is, non-original or ineligible for copyright protection—then the plaintiff cannot establish that the defendant has infringed the copyright. *See* 4 NIMMER ON COPYRIGHT § 13.01[A]. The only element of the validity of Varsity's copyright that is at issue in this appeal is whether Varsity's designs are protectable subject matter under the Copyright Act. *See* Appellant Br. at 1–2, 16–18; Appellee Br. at 3, 20–22. The parties do not address the originality of the designs, and therefore we do not address that issue now.

Varsity challenges the district court's entry of summary judgment with respect to the copyright claims on three grounds. First, Varsity argues that the district court did not afford appropriate deference to the Copyright Office's determination of copyrightability. Second, Varsity contends that the district

court used the wrong approach to determine whether a design is a protectable pictorial, graphic, or sculptural work that is separable from the utilitarian aspects of the article. Third, Varsity asserts that its designs are copyrightable as a matter of law because they are graphic works and not useful articles. We address each of these arguments in turn.

A. Copyright Registration and the Presumption of Validity

Varsity has successfully registered all five of the designs at issue with the Copyright Office. Congress has bestowed upon those who have obtained copyright registration "made before or within five years after first publication of the work" a presumption of validity "[i]n any judicial proceeding[]." 17 U.S.C. § 410(c) (2012). A certificate of registration "constitute[s] prima facie evidence of the validity of the copyright and of the facts stated in the certificate." *Id.* That presumption is rebuttable; once the plaintiff introduces evidence that he registered the work "before or within five years after first publication," *id.*, then the burden shifts to the alleged infringer to present evidence that the plaintiff's copyrights are invalid, *Hi-Tech Video Prods., Inc. v. Capital Cities/ABC, Inc.*, 58 F.3d 1093, 1095 (6th Cir. 1995). "The evidentiary weight to be accorded the certificate of a registration made" more than "five years after first publication of the work" "shall be within the discretion of the court." 17 U.S.C. § 410(c).

Three of Varsity's designs were registered within five years after first publication, Appellant Br. at 21, and therefore Star "shoulders the burden of rebutting the presumptive validity of [those three] copyright[s]," *Lexmark*, 387 F.3d at 534. Varsity registered the other two designs five years and six

months and six years and four months after first publication, Appellant Br. at 22, and so we have discretion to view the registrations for these two designs as evidence of validity if we wish. The district court acknowledged the statutory presumption afforded the three designs, but treated the presumption as "'fairly easy to rebut because the Copyright Office tends toward cursory issuance of registrations.'" R. 199 at 6 n.2 (D. Ct. Op. & Order) (Page ID #4300) (quoting *Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417, 430 (4th Cir. 2010)). Varsity takes umbrage with the district court's treatment of its presumption of validity and argues that courts should give deference to the Copyright Office's determinations about the originality and separability of Varsity's designs under *Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc.*, 467 U.S. 837 (1984), or *Skidmore v. Swift & Co.*, 323 U.S. 134 (1944). Appellant Br. at 25–26. What deference must we give to the Copyright Office's determination that Varsity's designs are non-functional and separable from the "utilitarian aspects of the article" to which they are affixed: *Chevron*, *Skidmore*, or none?

Chevron deference is appropriate not only when "Congress . . ha[s] expressly delegated authority or responsibility to implement a particular provision or fill a particular gap." *United States v. Mead Corp.*, 533 U.S. 218, 229 (2001). We must also give "judicial [*Chevron*] deference" to an agency's "interpretive choices" when "the agency's generally conferred authority and other statutory circumstances [make apparent] that Congress would expect the agency to be able to speak with the force of law when it addresses ambiguity in the statute or fills a space in the enacted law, even one about which 'Congress did

not actually have an intent' as to a particular result." *Id.* (quoting *Chevron*, 467 U.S. at 845). In these circumstances, "any ensuing regulation is binding in the courts unless procedurally defective, arbitrary or capricious in substance, or manifestly contrary to the statute." *Id.* at 227. Courts should give *Chevron* deference to an agency interpretation when Congress "provides for a relatively formal administrative procedure tending to foster the fairness and deliberation that should underlie a pronouncement of such force." *Id.* at 230.

In some circumstances, however, when Congress has not expressly or impliedly delegated to an agency the power to promulgate rules with the power of law, courts need not give *Chevron* deference to the agency's interpretation. *Id.* at 234 (holding that tariff-classification ruling letters "are beyond the *Chevron* pale"). Nevertheless, agency interpretations of a statute deserve "respect proportional to [the interpretations'] 'power to persuade,'" otherwise known as *Skidmore* deference, *see id.* at 235, when the agency has "specialized experience and broader investigations and information available" than those available to the judiciary, *id.* at 234 (internal quotation marks omitted).

We have not resolved the level of deference courts must accord certifications of copyright registration, but our sibling circuits have shown some deference to the Copyright Office's interpretations of the Copyright Act. The Second Circuit gives some deference to the Copyright Office's *Circular for Copyright Registration on Form SE* as an interpretation of whether copyright registration of serial publications serves as registration for the independently authored contributions that were published in

the serial issue. *See Morris v. Bus. Concepts, Inc.*, 283 F.3d 502, 505–06 (2d Cir. 2002) (citing *Mead Corp.*, 533 U.S. 218) ("In this case, however, we find the Office's interpretation persuasive."). Sitting en banc, the Third Circuit has held that the Copyright Office's "longstanding practice of denying registration to [a category of works] merits deference, but declined to label that deference "*Skidmore* deference." *Southco, Inc. v. Kanebridge Corp.*, 390 F.3d 276, 286 & n.5 (3d Cir. 2004) (en banc) (Alito, J.) ("We do not decide what degree of deference is warranted under the circumstances. At a minimum the practice of the Copyright Office reflects a body of experience and informed judgment to which courts and litigants may properly resort for guidance.") (internal quotation marks omitted)). Noting that "'[c]ourts have twisted themselves into knots trying to create a test to effectively ascertain whether the artistic aspects of a useful article can be identified separately from and exist independently of the article's utilitarian function,'" the Ninth Circuit rejected *Chevron* deference for the Copyright Office's *Compendium* and opinion letters, but held that *Skidmore* deference was appropriate. *Inhale, Inc. v. Starbuzz Tobacco, Inc.*, 755 F.3d 1038, 1041–42 & n.2 (9th Cir. 2014) (quoting *Masquerade Novelty, Inc. v. Unique Indus.*, 912 F.2d 663, 670 (3d Cir. 1990)) (also citing *High Sierra Hikers Ass'n v. Blackwell*, 390 F.3d 630, 638–39 (9th Cir. 2004)); *see also Alaska Stock, LLC v. Houghton Mifflin Harcourt Publ'g Co.*, 747 F.3d 673, 685 n.52 (9th Cir. 2014) ("Because the [copyright registration] forms created by the Copyright Office are statutorily authorized, it is possible that they qualify for the more deferential *Chevron* deference under *Mead*," but not deciding the question because applying *Skidmore* deference was

sufficient). Similarly, the Eleventh Circuit has held that courts should give "some deference" to the Copyright Office's decision to *deny* an application for copyright registration because of "the considerable expertise of the Register in defining the boundaries between copyrightable works of art and noncopyrightable industrial designs."[4] *Norris Indus., Inc. v. Int'l Tel. & Telegraph Corp.*, 696 F.2d 918, 922 (11th Cir. 1983); *see also Olem Shoe Corp. v. Wash. Shoe Corp.*, 591 F. App'x 873, 882 n.10 (11th Cir. 2015) (giving *Skidmore* deference to the Copyright Office Compendium's construction of the meaning of "preexisting work" because "copyright law is 'highly detailed' and it is apparent that the Copyright Office 'can bring the benefit of specialized experience to bear on the subtle questions of this case.'" (quoting *Mead*, 533 U.S. at 235)).

We now hold that the Copyright Office's determination that a design is protectable under the Copyright Act is entitled to *Skidmore* deference. Individual decisions about the copyrightability of works are not like "rules carrying the force of law," which command *Chevron* deference. *Mead*, 533 U.S. at 226–27. Like tariff-classification rulings, which the Supreme Court held are entitled to *Skidmore*—not *Chevron*—deference, *id.* at 235, copyright registration is not "a product of such formal process," *id.* at 235, or the type of process that suggests that the Copyright Office is engaging in any sort of rulemaking when issuing certificates of registration.

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[4] That the Eleventh Circuit did not label the degree of deference owed to the Copyright Office "*Skidmore*" or "*Chevron* deference" is unsurprising; *Norris* preceded *Chevron* by a year. *See Chevron*, 467 U.S. at 837 (decided in 1984).

And, although the Copyright Office is "charged with applying [the Copyright Act]," and therefore "necessarily make[s] all sorts of interpretive choices," *id.* at 227, these choices are akin to tariff-ruling letters because they apply to individual applications and are conclusive only as to the application under review,[5]

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[5] The Court noted that tariff-classification letters do not qualify for *Chevron* deference in part because "Customs has regarded a classification as conclusive only as between itself and the importer to whom it was issued " *Mead*, 533 U.S. at 233. Copyright registration certainly affects artists other than the copyright owner because registration prevents other artists from copying the copyright owner's work without authorization. 17 U.S.C. § 106 ("[T]he owner of copyright under this title has the exclusive rights to do and to authorize any of the following "); *id.* § 113(a) ("[T]he exclusive right to reproduce a copyrighted pictorial, graphic, or sculptural work in copies under section 106 includes the right to reproduce the work in or on any kind of article, whether useful or otherwise."); *id.* § 501(a) ("Anyone who violates any of the exclusive rights of the copyright owner is an infringer of the copyright or right of the author, as the case may be."). But the Copyright Office's decision to register the copyright does not create a rule of general applicability that affects future registration decisions except to the extent that the Copyright Office may not register copyrights that are substantially similar to copyrights that have already been registered. *See id.* § 102 ("Copyright protection subsists, in accordance with this title, in original works of authorship "); *id.* § 410(b) ("In any case in which the Register of Copyrights determines that, in accordance with the provisions of this title, the claim is invalid for any other reason, the Register shall refuse registration and shall notify the applicant in writing of the reasons for such refusal."). Nevertheless, the Court made clear that "precedential value alone does not add up to *Chevron* entitlement; interpretive rules may sometimes function as precedents, and they enjoy no *Chevron* status as a class." *Mead*, 533 U.S. at 232 (internal citation omitted). When "any precedential claim of a ruling is counterbalanced by the provision for independent review,"

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see id. at 233–34. Hence, we conclude that the Copyright Office's decision to issue a certificate of copyright registration is "beyond the *Chevron* pale." *Id.* at 234.

How much to defer to the determination to issue a copyright registration depends on "'the thoroughness evident in [the agency's] consideration, the validity of its reasoning, its consistency with earlier and later pronouncements, and all those factors which give it power to persuade, if lacking the power to control.'" *Mead*, 533 U.S. at 228 (quoting *Skidmore*, 323 U.S. at 140). The Copyright Office unquestionably has experience identifying useful articles and pictorial, graphic, and sculptural works. The Copyright Office publishes an internal manual that instructs its employees who are tasked with reviewing and registering copyrights how to apply the relevant provisions of the Copyright Act uniformly. *See* COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES ") §§ 903.1, 924–924.3(D) (3d ed. 2014) [hereinafter COMPENDIUM III]. In addition, the evidence in the record suggests that the Copyright Office consistently applied the same interpretation of separability to Varsity's numerous designs like the ones at issue in this case, which Varsity successfully registered with the Copyright Office. *See* R. 173-6 (Carroll Decl. Ex. A) (Page ID #2541–2605). Comparison between the designs at issue in this case and the other Varsity registered designs confirms that the Copyright Office consistently found the arrange-

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then the precedential effect of a ruling does not entitle that ruling to *Chevron* deference. *Id.*

ments of stripes, chevrons, and color-blocking to be original and separable from the utilitarian aspects of the articles on which they appear, and therefore copyrightable. *Compare id*, *with* Appellant Br. at 6–10. Not only do the letters demonstrate that the Copyright Office has interpreted the Copyright Act consistently, they also demonstrate that the Copyright Office has grounded its decisions to register Varsity's designs in the text of the statute using sound legal reasoning. *See* R. 173-6 at 8, 13 (Carroll Decl. Ex. A) (Page ID #2548–49, 2553). Finally, the Copyright Office's expertise in identifying and thinking about the difference between art and function surpasses ours. *See Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 994 (2d Cir. 1980) ("The Copyright Office continually engages in the drawing of lines between that which may be and that which may not be copyrighted.").

Thus, the district court erred by failing to give greater deference to the Copyright Office's registration determinations. This is not to say that the presumption of validity is irrebuttable. It is not. *Hi-Tech*, 58 F.3d at 1095; *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 908 (2d Cir. 1980). Star must bear the burden to overcome the presumption. We turn now to address whether Star has done so here.

B. Useful Articles and Separable Designs

As an initial matter, we note that courts are divided about whether copyrightability is a question of law or fact. *Oracle Am., Inc. v. Google Inc.*, 750 F.3d 1339, 1353 n.3 (Fed. Cir. 2014) (noting circuit split); *Gaiman v. McFarlane*, 360 F.3d 644, 648–49 (7th Cir. 2004) (same). We need not resolve this question here. Although there may be cases where

"[t]he determination whether a [work] is a pictorial, graphic, or sculptural work, and not an uncopyrightable 'useful article' is a fact-intensive one," *Lanard Toys Ltd. v. Novelty, Inc.*, 375 F. App'x 705, 710 (9th Cir. 2010), this case is not one of them. The parties agree on the basic facts necessary to make a determination whether the pictorial, graphic, and sculptural features of Varsity's designs "can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article," 17 U.S.C. § 101, and therefore "there is no genuine dispute of material fact" for a jury to resolve because either Star or Varsity "is entitled to judgment as a matter of law," Fed. R. Civ. P. 56(a).

The Copyright Act of 1976 provides protection for "original works of authorship fixed in any tangible medium of expression . . ." 17 U.S.C. § 102(a) (2012). Among the "works of authorship" that the Act protects are "pictorial, graphic, and sculptural works." *Id.* § 102(a)(5). "'[P]ictorial, graphic, and sculptural works' include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans." *Id.* § 101. "'[T]he design of a useful article . shall be considered a pictorial, graphic, or sculptural work," and thus copyrightable, "only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." *Id.* "A 'useful article' is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." *Id.*

These provisions together require a two-part inquiry to determine whether an article is protectable: first, whether the design for which the author seeks copyright protection is a "design of a useful article," and if so, second, whether the design of the useful article "incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the [useful] article." *Id.* This second question is often referred to as testing the "separability" of the pictorial, graphic, or sculptural features of the design of a useful article. *See, e.g.*, COMPENDIUM III §§ 924.1–.2 ("When examining a useful article, the [Copyright] Office must determine whether the article contains any pictorial, graphic, or sculptural features that are separable from its utilitarian function."); *Gay Toys, Inc. v. Buddy L. Corp.*, 703 F.2d 970, 972 (6th Cir. 1983) ("'[U]seful articles' are not generally copyrightable, although certain features of 'useful articles' may be copyrighted separately."). This appeal primarily concerns the separability of the graphic features of Varsity's cheerleading-uniform designs.

1. Separability

Courts, scholars, and students have endeavored to create a test to determine whether pictorial, graphic or sculptural features "can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." 17 U.S.C. § 101; *see, e.g.*, 2 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 3:135–147 (2015); Note, Barton R. Keyes, *Alive and Well: The (Still) Ongoing Debate Surrounding Conceptual Separablility in American Copyright Law*, 69 OHIO ST. L.J. 109, 115–143 (2008); Shira Perlmutter, *Conceptual Separability and*

Copyright in the Designs of Useful Articles, 37 J. COPYRIGHT SOC'Y U.S.A. 339 (1990). We have not yet adopted an approach to determining whether the pictorial, graphic, or sculptural features of the design of a useful article are separable from the utilitarian aspects of a useful article, and so we do so now.

There are two ways to determine whether a pictorial, graphic, or sculptural work is separable from the utilitarian aspects of an article—physical separability and conceptual separability.[6] The

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[6] We recognize that the words "conceptual" and "physical" separability do not appear in the text of 17 U.S.C. § 101. The distinction derives from the legislative history of the Copyright Act of 1976, which first introduced the term "pictorial, graphic, and sculptural works" in order to provide "as clear a line as possible between copyrightable works of applied art and uncopyrighted works of industrial design." H.R. REP. NO. 1476, 94th Cong., 2d Sess. 47, 55 (1976). The House Judiciary Committee report about the amendment further clarified:

> A two-dimensional painting, drawing, or graphic work is still capable of being identified as such when it is printed on or applied to utilitarian articles such as textile fabrics, wallpaper, containers, and the like. The same is true when a statute [sic] or carving is used to embellish an industrial product or, as in the *Mazer* case, is incorporated into a product without losing its ability to exist independently as a work of art. On the other hand, although the shape of an industrial product may be aesthetically satisfying and valuable, the Committee's intention is not to offer it copyright protection under the bill. Unless the shape of an automobile, airplane, ladies' [sic] dress, food processor, television set, or any other industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted under the bill. The test of separability and indepen-

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Copyright Office defines the physical-separability test as follows: "Physical separability means that the useful article contains pictorial, graphic, or sculptural features that can be physically separated from the article by ordinary means while leaving the utilitarian aspects of the article completely intact." COMPENDIUM III § 924.2(A). The Copyright Office considers "[a] sufficiently creative decorative hood ornament on an automobile," which could be ripped from the hood of the automobile without destroying the ornament or the automobile, a physically separable sculptural aspect of the design of an automobile, which "can be identified separately from, and [is] capable of existing independently of, the utilitarian aspects of" the automobile. COMPENDIUM III § 924.2(A); 17 U.S.C. § 101.

Few scholars or courts embrace relying on the physical-separability test without considering

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> dence from "the utilitarian aspects of the article" does not depend upon the nature of the design—that is, even if the appearance of an article is determined by [a]esthetic (as opposed to functional) considerations, only elements, if any, which can be identified separately from the useful article as such are copyrightable. And, even if the three-dimensional design contains some such element (for example, a carving on the back of a chair or a floral relief design on silver flatware), copyright protection would extend only to that element, and would not cover the overall configuration of the utilitarian article as such.

Id. In light of this background, the Second Circuit has declared that "'[c]onceptual separability' is alive and well." *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1144 (2d Cir. 1987).

whether the pictorial, graphic, or sculptural features of an article are conceptually separable because the physical-separability test has limitations. The physical-separability test works well to draw the distinction between aesthetic articles and useful articles when the objects at issue are three-dimensional, such as statuettes that serve as lamp bases. *See Mazer v. Stein*, 347 U.S. 201 (1954). The test is less effective, however, when the article at issue is two-dimensional because it is nearly impossible physically to detach the article from the object on which it appears.[7] Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 744–45 (1983). And the statute expressly offers copyright protection to two-dimensional articles. 17 U.S.C. § 101 ("'Pictorial, graphic, and sculptural' works include two-dimensional . . works . ."). Moreover, the physical-separability test can lead to inconsistent results that turn on how the article is made. Keyes, *supra*, at 120. For example, if the artist makes the statuette separately before putting a lamp fixture on top of it, then it is copyrightable under the physical-separability test. In contrast, if the statuette is wired through the body with a lamp socket in the head,

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[7] Of course, there are a few examples where a two-dimensional design is physically separable from a useful article. Recently, the Eleventh Circuit held that décor paper design for laminate wood flooring was "physically severable" because the plaintiff "sells otherwise identical flooring that uses décor paper other than the Glazed Maple design," and thus "[t]he interchangeability of the paper designs" was evidence that the décor paper was physically separable from the useful flooring. *Home Legend, LLC v. Mannington Mills, Inc.*, 784 F.3d 1404, 1413 (11th Cir. 2015).

then the statuette may not be eligible for copyright protection. *Id.*

Since Congress passed the Copyright Act of 1976, no court has relied exclusively on the physical-separability test without considering whether the pictorial, graphic, or sculptural features of a design are conceptually separable from the utilitarian aspects of the useful article.[8] And we decline to be the first to reject conceptual separability altogether. To start, the House Report, which discusses the amendments to the Copyright Act, expressly refers to design "element[s] that, physically or conceptually, can be identified as separable from the utilitarian aspects of" a useful article. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 47, 55 (1976). We believe that

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[8] In 1978, the D.C. Circuit "rejected the idea of conceptual separability," *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 922 n.8 (7th Cir. 2004), when considering whether the Register of Copyrights had abused its discretion by denying registration for "the overall shape of certain outdoor lighting fixtures," *Esquire, Inc. v. Ringer*, 591 F.2d 796, 798 (D.C. Cir. 1978). The Copyright Act of 1976 did not apply in *Esquire* because the Copyright Act had not gone into effect yet. *Id.* at 799 n.8. Nevertheless, the D.C. Circuit considered the legislative history of the Copyright Act of 1976 in order to address whether "a protectable element of a utilitarian article must be separable 'physically *or conceptually*' from the utilitarian aspects of the design." *Id.* at 803. The court concluded that "any possible ambiguity raised by [the] isolated reference" to conceptual separability in the legislative history "disappears when the excerpt is considered in its entirety." *Id.* at 803–04. Since Congress passed the Copyright Act of 1976, the D.C. Circuit has not reconsidered whether the Act protects the pictorial, graphic, or sculptural features of useful articles that are conceptually—but not physically—separable from the utilitarian aspects of a useful article.

abandoning conceptual separability altogether is therefore contrary to Congress's intent. In addition, our sibling "circuits have been almost unanimous in interpreting the language of § 101 to include both types of separability," *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 922 n.8 (7th Cir. 2004) (collecting cases), and we see no reason to create a circuit split. Therefore, we hold that the Copyright Act protects the "pictorial, graphic, or sculptural features" of a design of a useful article even if those features cannot be removed physically from the useful article, as long as they are conceptually separable from the utilitarian aspects of the article.

When the Copyright Office "determines that the useful article contains pictorial, graphic, or sculptural features that cannot be physically separated" from the utilitarian aspects of the useful article, then the Copyright Office applies the "conceptual separability test." COMPENDIUM III § 924.2(B). "Conceptual separability means that a feature of the useful article is clearly recognizable as a pictorial, graphic, or sculptural work, notwithstanding the fact that it cannot be physically separated from the article by ordinary means." *Id.* For example, the Copyright Office considers the following works of art conceptually separable from useful articles: "[a]n engraving on a vase," a "carving on the back of a chair," "[a]rtwork printed on a t-shirt," or "[a] drawing on the surface of wallpaper." *Id.*

Courts have struggled mightily to formulate a test to determine whether "the pictorial, graphic, or sculptural features" incorporated into the design of a useful article "can be identified separately from, and are capable of existing independently of, the

utilitarian aspects of the [useful] article" when those features cannot be removed physically from the useful article. ROBERT P. MERGES, PETER S. MENELL & MARK A. LEMLEY, INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE 490 (6th ed. 2012). Through the years, courts and scholars have proposed or used the following approaches to conceptual separability:

(1) **The Copyright Office's Approach:** "A pictorial, graphic, or sculptural feature satisfies [the conceptual-separability] requirement only if the artistic feature and the useful article could both exist side by side and be perceived as fully realized, separate works—one an artistic work and the other a useful article." COMPENDIUM III § 924.2(B).

(2) **The Primary-Subsidiary Approach:** A pictorial, graphic, or sculptural feature is conceptually separable if the artistic features of the design are "primary" to the "subsidiary utilitarian function." *Kieselstein-Cord*, 632 F.2d at 993.

(3) **The Objectively Necessary Approach:** A pictorial, graphic, or sculptural feature is conceptually separable if the artistic features of the design are not necessary to the performance of the utilitarian function of the article. *Carol Barnhart, Inc. v. Economy Cover Corp.*, 773 F.2d 411, 419 (2d Cir. 1985).

(4) **The Ordinary-Observer Approach:** A pictorial, graphic, or sculptural feature is conceptually separable if "the design

creates in the mind of the ordinary[, reasonable] observer two different concepts that are not inevitably entertained simultaneously." *Id.* at 422 (Newman, J., dissenting).

(5) **The Design-Process Approach:** A pictorial, graphic, or sculptural feature is conceptually separable if the "design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences." *Brandir*, 834 F.2d at 1145; *see also Pivot Point*, 372 F.3d at 930–31; Robert C. Denicola, *supra*, at 741–45.

(6) **The Stand-Alone Approach:** A pictorial, graphic, or sculptural feature is conceptually separable if "the useful article's functionality remain[s] intact once the copyrightable material is separated." *Pivot Point*, 372 F.3d at 934 (Kanne, J., dissenting).

(7) **The Likelihood-of-Marketability Approach:** A pictorial, graphic, or sculptural feature is conceptually separable if "'there is substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities.'" *Galiano v. Harrah's Operating Co.*, 416 F.3d 411, 419 (5th Cir. 2005) (quoting 1 NIMMER ON COPYRIGHT § 2.08[B][3]).

(8) **Patry's Approach:** There [sic] no need to engage in a separability analysis if

> (A) the work is the design of a three-dimensional article, and (B) the design is not of a "useful article." 2 PATRY ON COPYRIGHT § 3:145. When determining whether pictorial, graphic, or sculptural features are protectable under the Copyright Act, the focus should be on whether those pictorial, graphic, or sculptural aspects are separable from the "utilitarian *aspects*" of the article, not the "article" because "the protected features need not be capable of existing apart from the article, only from its functional aspects." *Id.* § 3:146.[9] This task requires two additional steps. *Id.* First, the court "must be able to discern pictorial, graphic, or sculptural features." *Id.* Second, the pictorial, graphic, or sculptural features "must be capable of existing as *intangible* features independent of the utilitarian *aspects* of the useful article, not independent of the whole article " *Id.* This necessitates asking "whether the pictorial, graphic, or sculptural features are dictated by the form or function of the utilitarian aspects of the useful article." *Id.* If form or function—rather than aesthetics—dictates the way that the

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9 Patry recommends abolishing the distinction between "physical" and "conceptual" separability entirely. 2 PATRY ON COPYRIGHT § 3:146. We decline to abandon those terms because Congress specifically referenced physical and conceptual separability in the House Report discussing the Copyright Act of 1976. *See* H.R. REP NO. 1476.

pictorial, graphic, or sculptural features appear, then those pictorial, graphic, and sculptural features are not capable of existing independently of the utilitarian aspects of the useful article. *Id.*

(9) **The Subjective-Objective Approach:** Conceptual separability is determined by balancing (A) "the degree to which the designer's subjective process is motivated by aesthetic concerns"; and (B) "the degree to which the design of a useful article is objectively dictated by its utilitarian function." *See* Keyes, *supra*, at 141. "The first factor requires courts to consider the degree to which aesthetic concerns, as opposed to functional ones, motivate the designer." *Id.* The second factor considers whether "the design is mostly dictated by function" or "hardly dictated by function at all." *Id.* at 142. If the design of the useful article "is mostly dictated by function," then that fact "weigh[s] against conceptual separability, and therefore, against copyright protection." *Id.* If the design "is hardly dictated by function at all" then that fact "weigh[s] in favor of a finding of conceptual separability." *Id.*

In recent years, our colleagues on the Second and Fourth Circuits have used multiple of the above-listed approaches in the same case when analyzing whether the "pictorial, graphic, or sculptural features" of a design of a useful article "can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the [useful]

article." 17 U.S.C. § 101. In *Chosun International, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324, 325 (2d Cir. 2005), the Second Circuit addressed whether a company that created and manufactured plush Halloween costumes made to look like stuffed toy animals had a valid copyright in its costume designs. The district court dismissed the complaint pursuant to Federal Rule of Civil Procedure 12(b)(6) on the basis that the costumes were not copyrightable. *Id.* at 326. On appeal, the Second Circuit reversed, using multiple theories of copyrightability to explain why the designer-plaintiff's copyright-infringement claims could proceed. First, the court said that the costume's design elements could "be 'conceptualized as existing independently of their utilitarian function.'" *Id.* at 329 (quoting *Carol Barnhart*, 773 F.2d at 418). Second, the court concluded that, even if some of the aesthetic design elements merged with the utilitarian elements, and therefore were not conceptually separable, the design was conceptually separable if the "design elements can be identified as reflecting the designer's artistic judgment exercised *independently* of functional influences." *Id.* (quoting *Brandir*, 834 F.2d at 1145). Finally, the court noted that evidence may show that the plaintiff's designs were conceptually separable from the utilitarian function of the costume because the design "invoke[s] in the viewer a concept separate from that of the costume's 'clothing' function, and that their addition to the costume was not motivated by a desire to enhance the costume's functioning *qua* clothing"—a formulation of conceptual separability that harkens back to Judge Newman's ordinary-observer approach. *Id.* at 330; *see also Carol Barnhart*, 773 F.2d at 422 (Newman, J., dissenting) ("For the design features to be 'conceptually separate' from the

utilitarian aspects of the useful article that embodies the design, the article must stimulate in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function."); 2 PATRY ON COPYRIGHT § 3:141.

In *Jovani Fashion, Inc. v. Cinderella Divine, Inc.*, 808 F. Supp. 2d 542 (S.D.N.Y. 2011), the district court used multiple approaches to address the copyrightability of a designer's prom-dress designs. *See id.* at 549–52. To start, the district court identified the portion of the dress design that Jovani claimed was separable from the dress: "the selection and arrangement of sequins and beads and their respective patterns of the bust portion, as well as the wire-edged tulles added to the lower portion of the depicted dress." *Id.* at 549 (internal quotation marks omitted). First, the district court found that no element of the design could be "ripped off the" dress and "reused or resold" "in its freestanding form," and therefore the elements were not physically separable. *Id.* at 550. Despite the dress's "vague association with the aquatic," the district court concluded that the design did not "'invoke in the viewer a concept separate from that of the dress's 'clothing' function.'" *Id.* at 550 (internal brackets omitted) (quoting *Chosun*, 413 F.3d at 330). Second, the design failed the design-process test because "each of the individual elements [was] plainly fashioned to fit the specific needs of a prom dress." *Id.* Each element of the design was part of the dress: "[t]he cloth swatch containing the sequins and beads is formed to compose the bust portion of the dress; the ruched-satin fabric is shaped into a waistband; and the layers of tulle make up the dress's skirt." *Id.* Third, the "primary role of each element [of the dress's design] is to contribute to an attractive prom dress, or at

least to attempt to do so," and therefore the aesthetic components of the design were not primary over the utilitarian elements' function. *Id.* (citing *Kieselstein-Cord*, 632 F.2d at 993). Fourth, and finally, "none of the elements," standing alone, "has any marketable worth." *Id.* (citing *Galiano*, 416 F.3d at 421).

Our colleagues on the Second Circuit affirmed, "largely for the reasons stated by the district court." *Jovani Fashion, Inc. v. Fiesta Fashions*, 500 F. App'x 42, 44 (2d Cir. 2012). The court additionally explained that "the artistic judgment exercised in applying sequins and crystals to the dress's bodice and using ruched satin at the waist and layers of tulle in the skirt does not invoke in the viewer a concept other than that of clothing . . ." *Id.* at 45. Thus, the court concluded that "these design elements are used precisely to enhance the functionality of the dress as clothing for a special occasion," and therefore "the aesthetic merged with the functional to cover the body in a particularly attractive way for that special occasion." *Id.* Finally, the Second Circuit acknowledged "that clothing, in addition to covering the body, serves a 'decorative function,' so that the decorative elements of clothing are generally 'intrinsic' to the overall function, rather than separable from it." *Id.* (citing *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452, 455 (2d Cir. 1989)).

The Fourth Circuit also uses this "hybrid" approach to conceptual separability. In *Universal Furniture*, the court considered whether decorative elements adorning furniture, a useful article, were eligible for copyright protection. 618 F.3d at 433. In reaching the conclusion that the design features were protectable, the Fourth Circuit used two approaches to conceptual separability. *Id.* at 434. Our

colleagues used the objectively necessary approach: "[T]he designs are 'wholly unnecessary' to the furniture's utilitarian function." *Id.* (quoting *Carol Barnhart*, 773 F.2d at 419); *see also id.* at 435 ("[The decorative elements'] form is not 'inextricably intertwined' with the function of furniture.") (quoting *Carol Barnhart*, 773 F.2d at 419). They also applied the design-process approach: "[The designer's] process reflects an 'artistic judgment exercised independently of functional influences.'" *Id.* at 434 (quoting *Pivot Point*, 372 F.3d at 931). The Fourth Circuit did not apply or consider any other approaches.

These cases from the Second and Fourth Circuits illustrate that it is difficult to select one approach to the question whether an artistic design is conceptually separable from the utilitarian aspects of the article. We adopt a similar hybrid approach now.

2. The Sixth Circuit Approach to Identifying Pictorial, Graphic, and Sculptural Works

We believe the best approach to determining whether a design is a copyrightable "pictorial, graphic, or sculptural work[]," 17 U.S.C. § 102, is to ask a series of questions that are grounded in the text of the Copyright Act: (1) Is the design a pictorial, graphic, or sculptural work? (2) If the design is a pictorial, graphic, or sculptural work, then is it a design of a useful article—"an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information"? *Id.* If the design is not the design of a useful article, then there is no need to inquire into whether there are "pictorial, graphic, or sculptural features that can be identified separately from, and

are capable of existing independently of, the utilitarian aspects of the [useful] article." 17 U.S.C. § 101.

Before addressing separability, a court should ask: (3) What are the utilitarian aspects of the useful article? For example, the utilitarian aspect of a chair is to provide a place for a person to sit. "Portray[ing] the appearance of the [useful] article" and "convey-[ing] information" are two utilitarian aspects that courts may not use to determine whether pictorial, graphic, or sculptural features are separable. 17 U.S.C. § 101 (defining "useful article"). We believe that considering these two functions' "utilitarian aspects" in addition to an article's other utilitarian functions for the purpose of determining the separability of a graphic design would be at odds with the Copyright Act's definition of what makes an article a useful article.

Not only is this approach consistent with the text of the Copyright Act, it is consistent with the holdings of our sibling circuits. In *Hart v. Dan Chase Taxidermy Supply Co.*, 86 F.3d 320, 323 (2d Cir. 1996), the defendant in a copyright-infringement suit argued that fish mannequins "act as a mount for [fish] skin," and therefore the sculptural features of the mannequins were not separable from the mannequin's display function. The Second Circuit rejected that argument because "fish mannequins, even if considered 'useful articles,' are useful insofar as they 'portray the[ir] appearance.'"[10] *Id.* (quoting 17 U.S.C.

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[10] *Hart* distinguished the *Barnhart* court's conclusion that "styrene human torsos used to display blouses and sweaters were not copyrightable" because they were "useful articles," *id.* One key distinction was that, in *Barnhart*, "the parties had stipulated that the torsos were 'useful articles' that were

[Footnote continued on next page]

§ 101); *see also Superior Form Builders, Inc. v. Dan Chase Taxidermy Supply Co.*, 74 F.3d 488, 494 (4th Cir. 1996) ("To the extent that an argument can be made that [animal] mannequins . . perform a utilitarian function—other than portraying themselves—by supporting the mounted skins, we believe the function to be conceptually separable from the works' sculptural features."). And the Second Circuit recently "express[ed] skepticism" about the contention that masquerading is a useful function because masquerading involves "portray[ing] the appearance of something (like a lion, ladybug, or orangutan), and in so doing, . cause[s] the wearer to be associated with, or appear as, the item portrayed." *Chosun*, 413 F.3d at 329–30 n.3.

Once we have identified permissible utilitarian aspects, we ask the final two questions that have to do with separability. (4) Can the viewer of the design identify "pictorial, graphic, or sculptural features" "separately from the utilitarian aspects of the [useful] article[?]" 17 U.S.C. § 101. If the viewer cannot identify pictorial, graphic, or sculptural features within the design of the useful article, then the design of the useful article is not copyrightable. (5) Can "the pictorial, graphic, or sculptural features" of the design of the useful article "exist[] independently of[] the utilitarian aspects of the [useful] article[?]" *Id.*

[Footnote continued from previous page]
designed 'to display clothes.'" *Id.* (citing *Barnhart*, 773 F.2d at 414, 418). In addition, the torsos at issue in *Barnhart* "were little more than glorified coat-racks used to display clothing in stores," and thus the *Hart* court concluded that the torsos were distinguishable from fish mannequins, which depict "the shape, volume, and movement of the animal." *Id.*

The objectively necessary approach is useful to answer this final question. If the pictorial, graphic, or sculptural features of the design of the useful article are "not required by [the useful article's] utilitarian functions" or are "wholly unnecessary to performance of the utilitarian function" of the useful article, then the pictorial, graphic, or sculptural features are not dictated by the function of the useful article, and therefore can exist without the useful article. *Carol Barnhart*, 773 F.2d at 419. The design-process approach may also help courts determine whether a design feature is necessary to the utilitarian aspects of the article because the designer's testimony may offer clues as to which components of the design are essential to the functionality of the useful article. *See Pivot Point*, 372 F.3d at 931–32 (employing the design-process approach to determine whether the design of a head mannequin is conceptually separable from the mannequin's utilitarian aspects). But we do not endorse the design-process approach in its entirety. Finally, the Copyright Office has provided a helpful way to think about answering questions four and five: the pictorial, graphic, and sculptural features incorporated into the design of a useful article are conceptually separable if "the artistic feature [of the design] and the useful article could both exist side by side and be perceived as fully realized, separate works—one an artistic work and the other a useful article." COMPENDIUM III § 924.2(B). If the viewer of a design can imagine the pictorial, graphic, or sculptural features of the design of a useful article as an artistic work, then those features are separately identifiable and can exist independently.

We do not endorse looking at why the designer chose the ultimate design as the final expression of the result she was trying to achieve to the exclusion

of other evidence. Nor do we adopt the likelihood-of-marketability test because it privileges a judge's personal taste[11] in popular art, is often based entirely on conjecture, and is often undermined by the simple fact that the defendant in a copyright action has copied the work at issue. *Carol Barnhart*, 773 F.3d at 422 (Newman, J., dissenting); NIMMER, *supra* § 2.08[B] at 2–96.3; *Home Legend, LLC v. Mannington Mills, Inc.*, 784 F.3d 1404, 1412 (11th Cir. 2015) (holding that the district court's conclusion that the plaintiff's design was not marketable "was based not on evidence but on conjecture" and that evidence that the defendant copied the plaintiff's design was evidence that the design had "some value; otherwise [the defendant] would not have copied it."). We also may not consider "the intention of the author as to the use of the work" in

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[11] Justice Holmes cautioned judges against injecting their personal taste into copyright law:

> It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge.

Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 251–52 (1903).

determining whether a pictorial work is registrable. 37 C.F.R. § 202.10(a).

With this background in mind, we now turn to address whether Varsity's designs "incorporate[] pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the [useful] article." 17 U.S.C. § 101.

C. Varsity's Designs

Question One: We begin our analysis by first identifying whether Varsity's designs are "pictorial, graphic, or sculptural works." 17 U.S.C. § 101. Varsity's designs, for which they received copyright registration, are "two-dimensional works of . graphic . . art." *Id.*; *see also, e.g.*, R. 1-15 at 2 (Compl. Ex. 15) (Page ID #48) (Varsity's certificate of registration for design 078 for "2-Dimensional artwork"); R. 1 16 at 2 (Compl. Ex. 16) (Page ID #51) (design 0815 registered for "2-Dimensional artwork").

Question Two: Are Varsity's designs "design[s] of useful article[s?]" 17 U.S.C. § 101. Varsity's designs are sketches that depict cheerleading crop tops and skirts—the components of a cheerleading uniform. *See* R. 1-15 at 2 (Compl. Ex. 15) (Page ID #48); R. 1 16 at 2–3 (Compl. Ex. 16) (Page ID #51–52); R. 1 17 at 2 (Compl. Ex. 17) (Page ID #54); R. 1-18 at 2 (Compl. Ex. 18) (Page ID #57); R. 51-1 at 2 (1st Am. Compl. Ex. 9) (Page ID #536). In other words, they are designs of cheerleading uniforms and sportswear, which have an "intrinsic utilitarian function that is not merely to portray the appearance of [clothing] or to convey information." 17 U.S.C. § 101.

Question Three: What are the "utilitarian aspects" of cheerleading uniforms? Cheerleading uniforms have "an intrinsic utilitarian function," namely to "cover the body, wick away moisture, and withstand the rigors of athletic movements." Appellant Br. at 57. Star contends that cheerleading uniforms identify the wearer as a cheerleader and a member of a cheerleading team. *See* Appellee Br. at 32, 39, 51–52. But this is no different than saying that a utilitarian aspect of a cheerleading uniform is to convey to others the fact that the wearer of the uniform is a cheerleader for a particular team. *See* 17 U.S.C. § 101 ("A 'useful article' is an article having an intrinsic utilitarian function that is not merely to convey information."). And therefore Star's purported utilitarian aspect of a cheerleading uniform is an impermissible factor. *See supra* Section II.B.2.

It also appears that Star makes one final argument as to why Varsity's graphic designs cannot "be identified separately from, and are [in]capable of existing independently of, the utilitarian aspects of the article": the designs' "decorative function" is one of the "utilitarian aspects" of a cheerleader uniform. *See* Appellee Br. at 51–52 (citing *Jovani*, 500 F. App'x at 45). In *Jovani*, the Second Circuit wrote, "[C]lothing, in addition to covering the body, serves a 'decorative function,' so that the decorative elements of clothing are generally 'intrinsic' to the overall function, rather than separable from it." *Jovani*, 500 F. App'x at 45 (citing *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F. 2d 452, 455 (2d Cir. 1989)).

To the extent that Star contends that pictorial, graphic, or sculptural features are inextricably intertwined with the utilitarian aspects of a cheerleading uniform because they serve a decorative function, *see*

Appellee Br at 51–52, we reject that argument. Such a holding would render nearly all artwork unprotectable. Under this theory of functionality, Mondrian's painting would be unprotectable because the painting decorates the room in which it hangs. But paintings are copyrightable. *Gay Toys*, 703 F.2d at 973 ("But the statute clearly intends to extend copyright protection to paintings."). It would also render the designs on laminate flooring unprotectable because the flooring would be otherwise unattractive. But the Copyright Act protects flooring designs that "hid[e] wear or other imperfections in the product." *Home Legend*, 784 F.3d at 1412. And statuettes adorning the base of a lamp would not be copyrightable under this theory because they serve the function of decorating an otherwise boring lamp base. But they are copyrightable under certain circumstances. *Mazer*, 347 U.S. at 214.[12] Finally, holding that the decorative function is a "utilitarian aspect[] of [an] article," 17 U.S.C. § 101, would make all fabric designs, which serve no other function than to make a garment more attractive, ineligible for copyright protection. But it is well-established that fabric designs are eligible for copyright protection. *Accord Folio Impressions*, 837 F.2d at 763. We therefore conclude that a pictorial, graphic, or sculptural work's "decorative function" does not

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[12] *Mazer v. Stein* involved an interpretation of the Copyright Act of 1909. When Congress amended the Copyright Act in 1976 "add[ing] language to the definition of 'pictorial, graphic, and sculptural works' in an effort to make clearer the distinction between works of applied art protectable under the bill, and industrial designs not subject to copyright protection," it expressly relied upon *Mazer* to draft the amendment. H.R. REP. NO. 94-1476, at 54–55.

render it unable to "be identified separately from," or "[in]capable of existing independently of, the utilitarian aspects of the article." 17 U.S.C. § 101.

Question Four: Can we identify pictorial, graphic, or sculptural features seaparately [sic] from the parts of the cheerleading-uniform design, which cover the body, permit free movement, and wick moisture? We can identify graphic features of Varsity's designs—the arrangement of stripes, chevrons, zigzags, and color-blocking. The district court concluded that these graphic features are not separately identifiable from a cheerleading uniform because a cheerleading uniform "without team colors stripes, chevrons, and similar designs typically associated with sports in general, and cheerleading in particular, is not recognizable as a cheerleading uniform." R. 199 at 15 (D. Ct. Op. & Order) (Page ID #4309). We disagree. First, Varsity's graphic designs do not "enhance the [cheerleading uniform's] functionality *qua* clothing." *Chosun*, 413 F.3d at 330. A plain white cheerleading top and plain white skirt still cover the body and permit the wearer to cheer, jump, kick, and flip. *See* R. 173-1 at 18 (Spencer Decl. Ex. C) (Page ID #2426–27) (photos of plain white cheerleader uniforms). The top and skirt are still easily identified as cheerleading uniforms without any stripes, chevrons, zigzags, or color-blocking. *See id.* Moreover, the record establishes that not all cheerleading uniforms must look alike to be cheerleading uniforms. The five Varsity designs are examples of how a cheerleading uniform still looks like a cheerleading uniform no matter how different the arrangement of the stripes, chevrons, colorblocks, and zigzags appear on the surface of the uniform. All of Varsity's graphic designs are interchangeable. Varsity's customers choose among the designs in the

catalog, including the five designs at issue, select one of the designs, and then customize the color scheme. R. 173-3 at 3–4 (Williams Dep. at 22–23) (Page ID #2449–50). The interchangeability of Varsity's designs is evidence that customers can identify differences between the graphic features of each design, and thus a graphic design and a blank cheerleading uniform can appear "side by side"—one as a graphic design, and one as a cheerleading uniform. Compendium III § 924.2(B). We therefore conclude that each of these graphic design concepts can be identified separately from the utilitarian aspects of the cheerleading uniform.

Question Five: Can the arrangement of stripes, chevrons, color blocks, and zigzags "exist[] independently of" the utilitarian aspects of a cheerleading uniform? We believe they can. Varsity's designers sketch their designs and select, place, and arrange various graphic elements, "such as stripes, lines, chevrons, inverted chevrons, angles, curves, coloring, and shapes." R. 173-2 at 3 (Williams Decl. ¶ 4) (Page ID #2438). Varsity's production department either applies these graphic designs onto cheerleading uniforms or recreates the designs by sewing panels of fabric together. R. 173-1 at 3 (Spencer Decl. ¶ 5) (Page ID #2411). Varsity's designs "may be incorporated onto the surface of a number of different types of garments, including cheerleading uniforms, practice wear, t-shirts, warm-ups, and jackets, among other things." R. 173-2 at 2 (Williams Decl. ¶ 3) (Page ID #2437). This evidence establishes that the designs are transferrable to articles other than the traditional cheerleading uniform (crop top and skirt). *See* R. 173-1 at 21–27 (Spencer Decl. Ex. D) (Page ID #2429–35) (photos showing Varsity's designs sublimated onto fabric and showing uniforms with sub-

limated designs). In addition, the interchangeability of Varsity's various designs is evidence that the graphic design on the surface of the uniform does not affect whether the uniform still functions as a cheerleading uniform. Indeed, "nothing (save perhaps good taste) prevents" Varsity from printing or painting its designs, framing them, and hanging the resulting prints on the wall as art. *Home Legend*, 784 F.3d at 1413. We therefore conclude the arrangement of stripes, chevrons, color blocks, and zigzags are "wholly unnecessary to the performance of" the garment's ability to cover the body, permit free movement, and wick moisture. *Carol Barnhart*, 773 F.2d at 419.

Because we conclude that the graphic features of Varsity's designs "can be identified separately from, and are capable of existing independently of, the utilitarian aspects of [cheerleading uniforms]," we hold that Varsity's graphic designs are copyrightable subject matter. 17 U.S.C. § 101. This conclusion is faithful to the statutory text of the Copyright Act and consistent with other courts' treatment of the protectability of clothing and the pictorial and graphic features that appear on clothing under the Copyright Act. Courts have drawn a line between "fabric design" and "dress design." "Fabric designs" are "design[s] imprinted on a fabric, such as a rose petal, which in a completed dress may appear repeatedly throughout the dress fabric, or may appear but once on a given dress." 1 NIMMER ON COPYRIGHT § 2.08[H][1]. Take the work of Piet Mondrian, for example. Mondrian's artwork or design is separable as a work of art because not only is it possible to recreate the design on t-shirts, grocery bags, cellphone cases, or notebooks, but also it actually has been done: Yves St. Laurent used Mondrian's famous

color-blocking and thick, black stripes to create cocktail dresses known as the "Mondrian look." *See N. Coast Indus. v. Jason Maxwell, Inc.*, 972 F.2d 1031, 1032 (9th Cir. 1992) (holding that a jury should determine whether the presumption of a valid copyright for a design of the front of pullover tops based on Mondrian designs was rebutted by claimed lack of originality). Mondrian's arrangement of color blocks and use of stripes are pictorial and graphic features "that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of" Yves St. Laurent's dress.

In contrast, it is impossible either physically or conceptually to separate a "dress design," which "graphically sets forth the shape, style, cut, and dimensions for converting fabric into a finished dress or other clothing garment," from the utilitarian aspects of clothing, i.e., to cover, protect, and warm the body. 1 NIMMER ON COPYRIGHT § 2.08[H][1]. The shapes of the neckline (v-neck, square-neck, crew-neck), sleeves (short, long, puffy), skirt shape (a-line, pencil, midi, maxi), trouser cut (pleated, plain-front, cuffed), or pockets (patch, welt, jetted)—these are the components of a design that are inextricably connected with the utilitarian aspects of clothing: pockets store pencils or pens; pants and skirts cover the legs; shirts cover the torso modestly or less modestly depending on the neckline. The designs of these components of an article of clothing "can[not] be identified separately from, [or be] capable of existing independently of, the utilitarian aspects of the article [of clothing]." 17 U.S.C. § 101.

The Copyright Act protects fabric designs, but not dress designs. *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1002 (2d Cir. 1995); *Folio Impressions,*

Inc. v. Byer Cal., 937 F.2d 759, 763 (2d Cir. 1991). A designer may obtain valid copyrights for "a multicolored striped sweater with puffy leaf appliques" and a cardigan, "which has a squirrel and leaves appliqued onto its multipaneled front." *Knitwaves*, 71 F.3d at 999, appx. The sweater has a utilitarian function—to provide warm cover for the torso and arms—and the sweaters still perform that function without the leaf or squirrel designs. Similarly, the design of a rose and "the placement of that rose repeated in horizontal rows against an ornate background" on fabric receive copyright protection. *Folio Impressions*, 937 F.2d at 761, 763, 765. But the creative arrangement of sequins, beads, ribbon, and tulle, which form the bust, waistband of a dress, do not qualify for copyright protection because each of these elements (bust, waistband, and skirt) all serve to clothe the body. *Jovani*, 808 F. Supp. 2d at 550; R. 172-5 at 2 (Photos of Fiesta's and Jovani's designs) (Page ID #2383). And a collection of uniforms, which includes chef hats shaped like vegetables, tuxedo jackets with a "distinctive shawl collar styling with a deep V neckline," and semi-fitted jackets with princess seams and star buttons, does not receive copyright protection. *See Galiano*, 416 F.3d at 415 & n.3, 422.[13] Creative and arguably attractive as these articles may be, they are

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[13] The Fifth Circuit used the likelihood-of-marketability approach to hold that these uniform designs were not eligible for copyright protection. *See Galiano*, 416 F.3d at 421–22. We do not believe the outcome of that case would be any different under our approach, however, because the aesthetic features of these uniforms could not "be identified separately from," nor were they "capable of existing independently of, the utilitarian aspects of" the uniform pieces. 17 U.S.C. § 101.

merely inventive designs used to cover the wearer's body and hair. Thus, the design of these hats and jackets (useful articles) "can[not] be identified separately from," and are not "capable of existing independently of, the utilitarian aspects of" a hat or a jacket. 17 U.S.C. § 101.

Because we believe that the graphic features of Varsity's cheerleading-uniform designs are more like fabric design than dress design, we hold that they are protectable subject matter under the Copyright Act. We therefore enter summary judgment for Varsity solely on the issue of the protectability of Varsity's designs as pictorial, graphic, or sculptural works. Because we conclude that Varsity is entitled to judgment on the issue of whether its designs are "pictorial, graphic, or sculptural works" and not uncopyrightble [sic] "useful articles," there is no need to address whether expert testimony would be proper in this case to determine the copyrightability of a design, as Varsity requests. We express no opinion about whether Varsity's designs are ineligible for copyright protection because they lack originality or any other reason. The district court did not address Star's contention that Varsity's designs are unoriginal, *see* R. 176-2 at 13–14 (Def.'s Combined Mem. of Law in Opp'n to Pls.' Mot. for Summ. J. and Reply in Supp. of Its Mot. for Summ. J.) (Page ID #3287–88), and therefore we leave that issue for the district court to address in the first instance.

III. DISMISSAL OF THE STATE-LAW CLAIMS

The district court dismissed all of Varsity's state-law claims after finding a federal question lacking. R. 199 at 17 (D. Ct. Op. & Order) (Page ID #4311). District courts may decline to exercise supplemental jurisdiction over state-law claims if "the district

court has dismissed all claims over which it has original jurisdiction." 28 U.S.C. § 1367(c) (2012). Section 1367(c) does not obligate district courts to dismiss state-law claims after dismissal of all federal claims, nor does it require that they retain jurisdiction either except in a few circumstances. *Musson Theatrical, Inc. v. Fed. Express Corp.*, 89 F.3d 1244, 1254–55 (6th Cir. 1996). We review for an abuse of discretion the district court's decision to dismiss state-law claims after the dismissal of federal claims. *Id.* at 1254. Varsity contends that the district court erred by exercising this discretion to dismiss because it still had original jurisdiction under 28 U.S.C. § 1332 (2012).

We now vacate the district court's judgment dismissing Varsity's state-law claims for two reasons. First, because we hold that Varsity's designs are copyrightable graphic works, a federal claim remains. Second, Varsity should have the opportunity to amend its complaint to satisfy the requirements of diversity jurisdiction.

Star denies that Varsity sufficiently pleaded diversity jurisdiction because the complaint does not allege an amount in controversy or that the parties are diverse. Appellee Br. at 70. The party invoking federal jurisdiction—in this case, Varsity—bears the burden of proof that the federal courts have jurisdiction. *Cleveland Hous. Renewal Project v. Deutsche Bank Trust Co.*, 621 F.3d 554, 559 (6th Cir. 2010). Section 1332 vests federal courts with original jurisdiction "of all civil actions where the matter in controversy exceeds the sum or value of $75,000, exclusive of interest and costs, and is between . . citizens of different States . . ." 28 U.S.C. § 1332(a)(1). A corporation is a "citizen of every State

. by which it has been incorporated and of the State . where it has its principal place of business." *Id.* § 1332(c)(1). The three plaintiff corporations in this suit are incorporated in Delaware, Tennessee, and Minnesota, but all three identify Tennessee as their principal place of business. R. 1 at 1–2 (Compl. ¶¶ 2–4) (Page ID #1–2).

We assess the citizenship of limited liability corporations ("LLC") differently, however: an LLC "has the citizenship of each of its members." *Delay v. Rosenthal Collins Grp., LLC*, 585 F.3d 1003, 1005 (6th Cir. 2009). Varsity has not alleged the citizenship of Star's members in its complaint or first amended complaint. *See* R. 1 at 1–16 (Compl.) (Page ID #1–16); R. 51 at 1–2 (1st Am. Compl.) (Page ID #532–33). Because Varsity's complaint is currently insufficient to establish diversity jurisdiction under 28 U.S.C. § 1332(a), the proper course is to permit Varsity to seek leave to amend the complaint pursuant to Federal Rule of Civil Procedure 15(a)(2) to attempt to establish that all members of Star do not share citizenship with the three plaintiff corporations. *See Kelly v. Ky. Oak Mining Co.*, 491 F.2d 318, 320 (6th Cir. 1974) (holding that plaintiffs should be permitted to amend their complaint in order to cure a defective allegation of diversity jurisdiction). We leave it to the district court to decide in the first instance whether the sum or value of this case exceeds $75,000 as required by 28 U.S.C. § 1332(a)(1).

IV. CONCLUSION

Because the district court erroneously concluded that Varsity's designs were not copyrightable, we **VACATE** the judgment in favor of Star and enter partial judgment for Varsity on the sole issue of whether Varsity's designs are copyrightable pictorial,

graphic, or sculptural works. We also **VACATE** the order dismissing Varsity's state-law claims. We **REMAND** the case to the district court for further proceedings consistent with this opinion.

DISSENT

McKEAGUE, Circuit Judge, dissenting. The majority presents a thoughtful approach to this difficult "metaphysical quandary" that courts have wrestled with for years. *See Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417, 434 (4th Cir. 2010). I agree with the majority's general approach. We first define the work's function and then ask whether the claimed elements can be identified separately from, or exist independently of, that function. I depart with the majority's analysis, however, in how the function of these designs is defined. I would hold that there is no conceptual separability and that Varsity's designs are not copyrightable. I therefore dissent.

Function. The majority explains that the function of a cheerleading uniform is to wick away moisture and "permit the wearer to cheer, jump, kick, and flip." That broad definition could be used to describe all athletic gear. But the particular athletic uniforms before us serve to identify the wearer as a cheerleader. Without stripes, braids, and chevrons, we are left with a blank white pleated skirt and crop top. As the district court recognized, the reasonable observer would not associate this blank outfit with cheerleading. This may be appropriate attire for a match at the All England Lawn Tennis Club, but not for a member of a cheerleading squad.

A narrower approach to "function" finds support in other circuits' caselaw. In *Jovani Fashion, Ltd. v. Fiesta Fashions*, 500 F. App'x 42, 44 (2d Cir. 2012), the Second Circuit concluded that the function of a prom dress was to clothe the body "in an attractive way for a special occasion" because this "clothing, in addition to covering the body, serves a 'decorative function.'" *Id.* at 45 (citing *Whimsicality, Inc. v. Rubie's Costume Co.*, 891 F.2d 452, 455 (2d. Cir. 1989)). Why? Because "the decorative elements of clothing are generally 'intrinsic' to the overall function, rather than separable from it." *Id.* Similarly, the Fifth Circuit in *Galiano v. Harrah's Operating Co.*, 416 F.3d 411 (5th Cir. 2005), explained that a casino uniform's function is just that: to serve as a "casino uniform[]." *Id.* Clothing provides many functions, but a uniform at its core identifies its wearer as a member of a group. It follows that the stripes, braids, and chevrons on a cheerleading uniform are integral to its identifying function.

The majority rejects this categorization because this holding would purportedly "render nearly all artwork unprotectable." That's not true. It renders unprotectable only artwork that is integral to an item's utilitarian function. In defining that function, we are confined by caselaw and by common sense. Take a dresser, for example. The function of a dresser is to store clothes and other articles. Any ornamental designs displayed on the surface of a dresser are not integral to that function. *Cf. Universal Furniture*, 618 F.3d at 434. Those ornamental designs would therefore be copyrightable. *Id.* In contrast, a painting is not subject to the separability analysis because it does not qualify as a "useful article" under 17 U.S.C. § 101.

Separability. Once function is properly defined, it logically follows: the placement of the stripes, braids, and chevrons is not separable from that function. In *Jovani Fashion*, in relation to a prom dress, the court excluded from copyright "the arrangement of decorative sequins and crystals on the dress bodice; horizontal satin ruching on the dress waist; and layers of tulle on the skirt." 500 F. App'x at 44. Here, as in that case, there is no evidence that Varsity's designers "exercise[d] artistic judgment 'independently of functional influences,' rather than as a 'merger of aesthetic and functional considerations.'" *Id.* (quoting *Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987)). In both cases, the designers' aesthetic considerations merged with functional concerns: "to cover the body in an attractive way for a special occasion," *id.*, and to identify the wearer as a member of a particular cheerleading squad. Without the stripes, braids, and chevrons, a blank shell of a cheerleading uniform would lose an important dimension of its functional utility.

These designs are unlike other items that are copyrightable. Take the belt buckles in *Kieselstein-Cord v. Accessories by Pearl, Inc.*, 632 F.2d 989, 993 (2d Cir. 1980). The court in that case concluded that while belt buckles are utilitarian objects designed to hold pants in place, the claimed designs were "conceptually separable sculptural elements." *Id.* Here, unlike *Kieselstein-Cord*, Varsity's designs would lose their ability to identify the wearer as a cheerleader without these aesthetic elements. Rather than simply "giv[ing the pieces] a pretty face," *Universal Furniture*, 618 F.3d at 434 (discussing *Pivot Point Int'l, Inc. v. Charlene Products, Inc.*, 372 F.3d 913, 916 (7th Cir. 2004)), Varsity's designs enhance the

garment's utility. The claimed artistic choices thus cannot be separated from that function.

The majority notes that the Copyright Office's registration for Varsity's two-dimensional sketches is entitled to *Skidmore* deference. *See Hi-Tech Video Prods., Inc. v. Capital Cities/ABC, Inc.*, 58 F.3d 1093, 1095 (6th Cir. 1995). Fair enough, but "under *Skidmore*, we follow an agency's rule only to the extent it is *persuasive*." *Gonzales v. Oregon*, 546 U.S. 243, 269 (2006) (emphasis added). And this determination is not at all persuasive. It is not supported by the Copyright Act's "text and design." *Id.* Nor is it "consistent with the congressional purpose." *Morton v. Ruiz*, 415 U.S. 199, 237 (1974); *see also S. Rehab. Grp., P.L.L.C. v. Sec'y of Health & Human Servs.*, 732 F.3d 670, 685 (6th Cir. 2013). The Copyright Office's determination, therefore, does not change my conclusion.

The fact that Varsity's artistic choices may have been "'aesthetically satisfying and valuable'" likewise does not change this conclusion. *See Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 418 (2d Cir. 1985) (quoting H.R. REP. NO. 94-1476 at 55 (1976)). Rather, a more particularized assessment of function accounts for the inherent tension created by protection of clothing design in the Intellectual Property arena. In dicta, this Court has discussed questions implicated by extending copyright protection to articles with utilitarian value, like clothing. Recognizing copyright protection for items with utilitarian function "would allow for the protection of patent-like features without having to fulfill the rigorous standards for obtaining a design patent." *See Winfield Collection, Ltd. v. Gemmy Indus., Corp.*,

147 F. App'x 547, 550–52 (6th Cir. 2005) (citations omitted).

Ultimately, this case turns on how function is defined. How broadly should courts define the function of an article of clothing? Should they define it at its most basic function, to cover the body? Should they define it broadly, as the majority does in this case, as wicking away moisture and "permit[ting] the wearer to cheer, jump, kick, and flip"? Or should they define it more particularly, in relation to its specific purpose—as identifying the wearer as a cheerleader? *See Jovani Fashion*, 500 F. App'x at 44 (concluding that the function of a prom dress is "to cover the body in an attractive way for a special occasion"). For the above reasons I submit the more particularized assessment is more sensible and consonant with the purposes of the law.

* * *

It is apparent that either Congress or the Supreme Court (or both) must clarify copyright law with respect to garment design. The law in this area is a mess—and it has been for a long time. *See Fashion Originators Guild of Am. v. Fed. Trade Comm'n*, 114 F.2d 80, 81 (2d Cir. 1940) (Hand, J.). The majority takes a stab at sorting it out, and so do I. But until we get much-needed clarification, courts will continue to struggle and the business world will continue to be handicapped by the uncertainty of the law

I respectfully dissent.

UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TENNESSEE
WESTERN DIVISION

VARSITY BRANDS, INC., et al.,

Plaintiffs/Counter-Defendants,

Case No. 10-2508

v.

STAR ATHLETICA, LLC,

Defendant/Counter-Claimant.

_____/

OPINION AND ORDER GRANTING IN PART AND DENYING IN PART DEFENDANT'S MOTION FOR SUMMARY JUDGMENT, DENYING PLAINTIFF'S MOTION FOR SUMMARY JUDGMENT, AND DISMISSING PLAINTIFF'S STATE-LAW CLAIMS WITHOUT PREJUDICE

Classical philosophy does not often come to play in the field of mundane legal analysis. But today it does, because central to the question the court must resolve in this copyright infringement case is to think about, and come close to defining, the essence of a "cheerleading uniform." The philosopher Plato famously discussed the essence of a [sic] physical objects as separate from their ideal. Taking the example of a tree, we may well consider as a "tree" a thing with only a few branches and fewer leaves, because it still reflects, however poorly, the ideal we inherently know to be "tree." It possesses tree-ness. *See, e.g.*, Plato, *The Republic* 207, 253–58, 361–66 (Benjamin Jowett trans., Vintage Books 1991).

Here, the court's focus eventually turns to the "cheerleading-uniform-ness" of a fabric garment without any of the physical designs and colors ordinarily printed upon or otherwise imparted to a garment that identifies it, generally, as an unavoidably imperfect reflection of the ideal of a "cheerleading uniform." In this case, because the court finds that the absence of such designs and colors simply fails to call to mind, or otherwise signal the presence of a cheerleading uniform in the garment at hand, it must also conclude that the presence of such designs and colors is at the core of the ideal—of "cheerleading-uniform-ness." With that conclusion, it also follows that the colors-and-designs component of a cheerleading uniform cannot be conceptually separated from the utilitarian object itself. Copyright protection, as a matter of law, cannot apply.

In 2010, Defendant Star Athletica, LLC ("Star"), a marketer and designer of various sports apparel, published a catalogue advertising its designs for cheerleading uniforms. Upon learning of Star's catalogue, Plaintiffs Varsity Brands, Inc., Varsity Spirit Fashions and Supplies, Inc., and Varsity Spirit Corporation (collectively, "Varsity"), sued alleging copyright infringement, trademark infringement, and a variety of state-law claims. After discovery, the parties cross-moved for summary judgment.

For the reasons summarized above and explained below, the court will grant in part and deny in part Star's motion for summary judgment, and deny Varsity's motion for summary judgment. Varsity's remaining state-law claims will be dismissed without prejudice.

I. BACKGROUND

The following facts are undisputed. Varsity designs, manufactures, and sells apparel and accessories for use in cheerleading. (Pg. ID # 2228.) Star markets and sells various sports apparel, including cheerleading goods and uniforms. (Pg. ID # 2229.)

Varsity employs designers to create two-dimensional designs, some of which are incorporated onto the surface of cheerleading uniforms. (Pg. ID ## 2809, 2836.) It primarily uses two different methods for incorporating a design into a uniform: cutting and sewing and sublimation. (Pg. ID # 2810.) Cutting and sewing appears to be the more common method of incorporation, and it involves arranging panels of fabric and striped braid and sewing them together to resemble the intended design. (Pg. ID # 2810–11.) Sublimation involves printing the design on a piece of paper. The paper is then fed through a machine that heats the ink on the paper into a gas which is infused into the fabric by pressing the paper and fabric together.[1] (Pg. ID # 2811.)

Varsity's design team begins by sketching a design for a cheerleading uniform on paper. (*See* Pg. ID # 2837.) These designs are sketched over a model of a cheerleader, with the designer placing lines, curves, stripes, angles, diagonals, etc, in various colors and combinations over the sketched model. (*See, e.g.*, Pg. ID # 2842–45.) At the time a design is created, it is unknown whether it will actually be

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[1] The parties disagree regarding whether sublimation was actually used by Varsity for the fabric designs at issue in this litigation. This disagreement is not material to the court's opinion.

implemented on a cheerleading uniform. (Pg. ID # 2838.) While creating a uniform design, Varsity's designers are not given instructions, limitations, or guidelines from Varsity's production department. (*Id.*) If a finished garment does not look like the design it came from, the production department is instructed to try again. (Pg. ID # 2810, 2838.) In other words, the designers are not instructed to adapt their designs to the realities of production. (*Id.*)

Varsity registered five cheerleading uniform designs with the Copyright Office for the following Varsity design numbers: 074, 078, 0815, 299A, and 299B. (Pg. ID # 2230–31.) For three of these designs (074, 078, and 0815), Varsity submitted a sketch of the uniform as deposit material and the nature of the work and authorship is listed as "2-dimensional artwork." For the remaining two uniforms (299A and 299B), Varsity submitted a photograph of a completed uniform incorporating the design as deposit material, the nature of the work is listed as "fabric design (artwork)" and the nature of authorship is listed as "2-dimensional artwork." (Pg. ID # 2231–36.) Varsity claims that Star copied, reproduced, displayed, and distributed infringing images of these designs in its 2010 catalog and internet website, and that it infringed on Varsity's copyrights by incorporating the designs onto the surface of Star's cheerleading uniforms. (Pg. ID # 2310.) Varsity claims that pictures of cheerleading models wearing a selection of different styles of cheerleading uniform infringed its copyrights. (Pg. ID ## 3–4, 20, 24, 28, 32, 36.)

II. DISCUSSION

A. Standard

Summary judgment is appropriate "if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a). "In deciding a motion for summary judgment, the court must view the evidence in the light most favorable to the non-moving party, drawing all reasonable inferences in that party's favor." *Sagan v. United States*, 342 F.3d 493, 497 (6th Cir. 2003).

The movant has the initial burden of showing the absence of a genuine dispute as to a material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). The burden then shifts to the nonmovant, who must put forth enough evidence to show that there exists "a genuine issue for trial." *Horton v. Potter*, 369 F.3d 906, 909 (6th Cir. 2004) (citation omitted). The non-movant "must do more than simply show that there is some metaphysical doubt as to the material facts." *Matsushita v. Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586 (1986). Summary judgment, therefore, is not appropriate when "the evidence presents a sufficient disagreement to require submission to a jury." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 251–52 (1986).

B. Copyright Infringement (Counts I–V)

In order to establish copyright infringement, two elements must be proven: "(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original." *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 361 (1991). Determining whether an item is subject to copyright protection is question of law for the court to decide.

See Tastefully Simple, Inc. v. Two Sisters Gourmet, L.L.C., 134 F. App'x 1, 4 (6th Cir. 2005). Copyright protection extends to "pictorial, graphic, and sculptural works" ("PGS works"), which are defined as "two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, . . diagrams, models, and technical drawings." 17 U.S.C. §§ 101, 102(a)(5). Copyright protection for PGS works includes:

> works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a [PGS] work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article.

17 U.S.C. § 101. "A 'useful article' is an article having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information." *Id.*

Clothing possesses both utilitarian and aesthetic value.[2] *See, for example, Jovani Fashion, Ltd. v.*

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[2] Varsity argues that it is entitled to a presumption that its copyright is valid because it has introduced a certificate of registration made within five years of the first publication of three of the works at issue. *See* 17 U.S.C. § 410(c). However, courts have routinely noted that this presumption is "fairly easy to rebut because the Copyright Office tends toward cursory issuance of registrations." *See, e.g., Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417, 430 (4th Cir. 2010) (per curiam). Because, as discussed *infra*, other evidence

[Footnote continued on next page]

Fiesta Fashions, 500 F. App'x 42, 44 (2d Cir. 2012); *Galiano v. Harrah's Operating Co., Inc.*, 416 F.3d 411, 417 (5th Cir. 2005). To the extent that clothing design sets forth the shape, style, cut, and dimensions for converting fabric into a finished garment, the design is not copyrightable. M. Nimmer and D. Nimmer, 1 *Nimmer on Copyright* § 2.08[H][1]–[3], at 2-143–149 (2013). However, to the extent that a design sets forth a pattern that will be "imprinted on a fabric, such as a rose petal" the design may be copyrightable if it "can be identified separately from, and [is] capable of existing independently of, the utilitarian aspects of the article." *Id.*; 17 U.S.C. § 101. "[W]hile 'useful articles,' taken as a *whole*, are not eligible for copyright protection, the individual design elements comprising these items may, viewed *separately*, meet the Copyright Act's requirements." *Chosun Int'l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324, 328 (2d Cir. 2005) (emphasis in original). The question whether a design is separable from the utilitarian aspects of an article has "presented courts with significant difficulty." *Pivot Point Int'l, Inc. v. Charlene Prods., Inc.*, 372 F.3d 913, 921 (7th Cir. 2004). As one leading commentator notes: "Of the many fine lines that run through the Copyright Act, none is more troublesome than the line between protectible [PGS] works and unprotectible utilitarian elements of useful articles." Paul Goldstein, 1 *Goldstein on Copyright* § 2.5.3, at 2:67 (3d ed. 2013).

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in the record exists which suggests that the works at issue are non-copyrightable utilitarian articles, this presumption is easily dispensed with. *See Fonar Corp. v. Domenick*, 105 F.3d 99, 105 (2d Cir. 1997).

In addition to providing a thoughtful and comprehensive assessment of the development of the law in this area, *Pivot Point* summarizes the variety of tests that courts have used in considering the issue:

> 1) the artistic features are "primary" and the utilitarian features "subsidiary," *Kieselstein-Cord* [*v. Accessories by Pearl, Inc.*], 632 F.2d [989,] 993 [2d Cir. 1980]; 2) the useful article "would still be marketable to some significant segment of the community simply because of its aesthetic qualities," Melville B. Nimmer & David Nimmer, 1 Nimmer on Copyright § 2.08[B][3], at 2–101 (2004); 3) the article "stimulate[s] in the mind of the beholder a concept that is separate from the concept evoked by its utilitarian function," *Carol Barnhart* [*Inc., v. Econ. Cover Corp.*], 773 F.2d [411,] 422 (Newman, J., dissenting); 4) the artistic design was not significantly influenced by functional considerations, *see Brandir Int'l*, [*Inc. v. Cascade Pac. Lumber Co.*], 834 F.2d at 1145 (adopting the test forwarded in [Robert C.] Denicola, [*Applied Art & Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 Minn. L. Rev. 707, 741 (1983)]); 5) the artistic features "can stand alone as a work of art traditionally conceived, and . . the useful article in which it is embodied would be equally useful without it," Goldstein, 1 [*Goldstein on*] *Copyright* § 2.5.3, at 2:67; and 6) the artistic features are not utilitarian, *see* William F. Patry, 1 *Copyright Law & Practice* 285 (1994).

Pivot Point, 372 F.3d at 923 (citations altered). Although it does not appear that the Sixth Circuit has addressed this issue, several recent out-of-circuit cases—including *Pivot Point*—are instructive.

In *Pivot Point*, the Seventh Circuit considered whether a mannequin head that imitated the "'hungry look' of high-fashion, runway models" could be copyrighted. *Id.* at 915. The mannequin head at issue was used as a model for hair stylists and cosmetic stylists to practice their craft. After summarizing the jurisprudential history of the separability standard in the Second Circuit, the Seventh Circuit concluded that "[c]onceptual separability exists when the artistic aspects of an article can be conceptualized as existing independently of their utilitarian function." *Id.* at 931. The court looked to "whether the design elements can be identified as reflecting the designer's artistic judgment exercised independently of functional influences." *Id.* (citation and quotation marks omitted). "If the elements do reflect the independent, artistic judgment of the designer, conceptual separability exists. Conversely, when the design of a useful article is as much the result of utilitarian pressures as aesthetic choices, the useful and aesthetic elements are not conceptually separable." *Id.* at 931 (citations and quotation marks omitted).

Applying what may be referred to as the "aesthetic influence test,"[3] the Seventh Circuit held

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[3] Judge Kanne criticized this test in his dissent, "All functional items have aesthetic qualities. If copyright provided protection for functional items simply because of their aesthetic qualities, Congress's policy choice that gives less protection in patent than copyright would be undermined." *Pivot Point*, 372 F.3d at 932 (Kanne, J., dissenting).

that the style of the mannequin's face existed independently of its functional concerns, namely facilitating easy make-up application and hair styling. *Id.* at 931–32. Instead, the designer was simply told to create a model reflecting the "hungry-look" of high fashion, and was free to implement that concept as he wished without regard to specifications for how far the mannequin's eyes needed to be apart, or how high the eyebrows should be. *Id.* at 932. The court concluded that because the mannequin's creative aspects "were meant to be seen and admired," its sculptural features existed independently from its utilitarian features and it was therefore entitled to copyright protection. *Id.* at 932.

The Fifth Circuit declined to apply the Seventh Circuit's aesthetic influence test to garment design in *Galiano*. In *Galiano*, the plaintiff was the founder and owner of a clothing design company that produced uniforms for Harrah's casinos, who applied for and received copyright protection for her sketches of a costume collection. 416 F.3d at 413. After the expiration of a consulting agreement with Harrah's, she sued Harrah's for continuing to use and order the uniforms she had designed. *Id.* at 414. The court looked to the marketability test proposed in *Nimmer on Copyright*: "[C]onceptual severability exists where there is any substantial likelihood that even if the article had no utilitarian use it would still be marketable to some significant segment of the community simply because of its aesthetic qualities." *Galiano*, 416 F.3d at 419; *Nimmer*, § 2.08[B][3], at 2-99. The court adopted the marketability test for garment design only, and noted that the test has the

benefits of being a "more determinate rule" that provides necessary clarity for the conceptual severability analysis.[4] *Galiano*, 416 F.3d at 421. Turning to the uniforms at issue in Galiano, the court concluded that the plaintiff had made no showing that its designs were marketable independent of their utilitarian function as casino uniforms. *Id.*

The Fourth Circuit recently applied *Pivot Point in Universal Furniture Int'l, Inc. v. Collezione Europa USA, Inc.*, 618 F.3d 417 (4th Cir. 2010) (per curiam), a case involving competing furniture companies. *Id.* at 424. Universal Furniture produced two collections of furniture that incorporated decorative carvings on the furniture; Collezione imitated these designs and produced similar furniture at lower cost. *Id.* The Fourth Circuit held that the decorative elements (as opposed to the shape) of Universal Furniture's designs could receive copyright protection. The court reasoned that the furniture compilations were "superfluous nonfunctional adornments for which the shape of the furniture (which is not copyrightable) serves as the vehicle. the designs are 'wholly unnecessary' to the furniture's utilitarian

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[4] *Nimmer* notes that its "likelihood-of-marketability test has the virtue of harmonizing various holdings in this fractured field[,]" but that the standard "can be critiqued as (1) strange to copyright; (2) liable to unduly favor more conventional forms of art; and (3) too restrictive." *Nimmer*, § 2.08[B][3], at 2-99–100. The Fifth Circuit acknowledged, but discounted, these critiques because "[as to (1)] all lawmaking with respect to PGS works is interstitial [sic], and most of it [is] freewheeling (2) is a salient concern only if we apply the marketability test across the spectrum of applied artwork[,] [and] (3) theoretical unfairness is outweighed by the interest in having a determinate rule." *Galiano*, 416 F.3d at 421 n.26.

function." *Id.* at 434. Turning to the *Pivot Point* aesthetic influence test, the court recognized that Universal Furniture's designer "was influenced by function in designing [the] decorative elements. After all, . 'furniture has got to function.'" *Id.* Nevertheless, the court held that the designer's artistic judgment was sufficiently independent because "his objective in compiling these decorative elements onto the basic shapes of the furniture was not to improve the furniture's utility but to 'give [the pieces] a pretty face.'" *Id.* The court further noted that the conceptual separability test provided in § 101 is conjunctive, but that as applied to decorations on furniture, the test presented a "metaphysical quandary" namely that "[t]he elements serve no purpose divorced from the furniture—they become designs in space." *Id.* However, because the designs were original and conceptually severable from utilitarian aspects of the furniture, the court concluded that the decorative features were entitled to copyright protection.

Two cases from the Second Circuit also bear mentioning. In *Chosun*, the court considered whether elements of a plush sculpted animal costume could be seperable [sic] from the overall design of the costume and thus eligible for protection under the Copyright Act. 413 F.3d at 329. The court vacated the district court's dismissal of the plaintiff's copyright claims, noting that "when a component of a useful article can actually be removed from the original item and separately sold, without adversely impacting the article's functionality, that physically separable design element may be copyrighted." *Id.* (emphasis added). This supports *Galiano*'s marketability test by incorporating a consideration of whether a design element could be separately marketed into the issue of conceptual severability.

The Second Circuit directly addressed garment design in *Jovani*, where the plaintiff appealed the dismissal of its copyright claim alleging that the defendant infringed a registered copyright for the design of a prom dress. 500 F. App'x at 43. The plaintiff argued that the "arrangement of decorative sequins and crystals on the dress bodice; horizontal satin ruching at the dress waist; and layers of tulle on the skirt" qualified as conceptually separable dress elements worthy of copyright protection. The court held that physical separability was impossible, as the "removal of these items would certainly adversely affect the garment's ability to function as a prom dress, a garment specifically meant to cover the body in an attractive way for a special occasion." *Id.* at 44. Similarly, the court held that conceptual severability was also impossible: "the artistic judgment exercised in applying sequins and crystals to the dress's bodice and in using ruched satin at the waist and layers of tulle in the skirt does not invoke in the viewer a concept other than that of clothing." *Id.* at 45. Instead, the decorative elements on the dress were used to enhance the functionality of the dress for a special occasion, merging the aesthetic with the functional in an attractive way for that special occasion. *Id.* Although the prom dresses at issue undoubtedly had artistic elements:

> the decorative choices . . . merge with those that decide how (and how much) to cover the body. Thus, a jeweled bodice covers the upper torso at the same time that it draws attention to it; a ruched waist covers the wearer's midsection while giving it definition; and a short tulle skirt conceals the wearer's legs while giving glimpses of them.

Id. The court concluded that because it was impossible to separate the aesthetic design from the functional effect of that design, copyright protection could not extend to cover plaintiff's dresses.

It is obvious that there is considerable disagreement regarding the proper standard to apply when considering whether elements of protectable PGS works are separable from their utilitarian function.

First, it is necessary to identify just what Varsity has copyrighted, and how Star is claimed to have violated these copyrights. Varsity copyrighted 2-dimensional artwork in five cheerleading uniform designs. (Pg. ID # 2230–36). For three of these designs, the deposit material constitued [sic] sketches of a cheerleader wearing a cheerleading uniform with the design at issue. For the remaining two designs, Varsity submitted a photograph of a completed uniform as the deposit material. Varsity claims that Star infringed its copyright in these designs by producing cheerleading uniforms that incorporated these designs, photographing models wearing these uniforms, and publishing photographs of the uniforms in its 2010 catalogue. As Varsity puts it, "Star has infringed all five of the Designs at Issue, by copying, reproducing, displaying and/or distributing its infringing images in its catalog and on its internet website, and by incorporating the designs onto the surface of its garments." (Pg. ID # 2301.)

The court begins its analysis with the words of the statute: "the design of a useful article, as defined in this section, shall be considered a [PGS] work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that *can be identified separately from, and are capable of existing independently of, the utilitarian aspects of*

the article." 17 U.S.C. § 101 (emphasis added). The first clause "sculptural features that can be identified separately from [the utilitarian aspects of the article]" implies conceptual severability, that is, whether the court can conceive of the allegedly copyrightable features as separate from the utilitarian article. The second clause that asks "are [the features] capable of existing independently of[] the utilitarian aspects of the article" implies physical separability; can the design exist independently of the utilitarian article? Although courts and commentators have recognized that there is substantial overlap between these two questions, each appears to be a separate inquiry under the statute.

Turning first to conceptual severability, Varsity argues that because its designers sketch the uniform designs independent of functional influences, its designs are conceptually separable from the utilitarian features of the cheerleading uniforms, and are therefore protected under the Seventh Circuit's aesthetic influence test. *See Pivot Point*, 372 F.3d at 931. Varsity points to statements from its Vice Presidents of Design and Production that the production team is forced to adapt their production of uniforms to the design given to them, and that designers are never asked to adapt their designs to the practical realities of production. Varsity argues that this lack of functional influence should predominate the conceptual separability test, and that the outer edge of the garment merely operates as the edge of a canvas, with unlimited possibilities therein.

However, this analysis does not meaningfully engage with the issue in this case. That is, can a cheerleading uniform be conceived without any ornamentation or design, yet retain its utilitarian

function as a cheerleading uniform? The Second Circuit's decision in *Jovani* is instructive on this point. As in *Jovani*, the combination of braids, chevrons, and stripes on the sketches does not invoke any concept other than that of clothing. Indeed, the sketches are clearly of clothing, in that they depict cheerleading uniforms on young women who appear to be cheerleaders. (*See, e.g.*, Pg. ID # 2842–45.) Similar to the prom dresses at issue in Jovani, a cheerleading uniform is "a garment specifically meant to cover the body in an attractive way for a special occasion." *Jovani*, 500 F. App'x at 44. The artistic judgment that is exercised in applying stripes, patterns, and chevrons, "does not invoke in the viewer a concept other than that of clothing." *Id.* at 45. Indeed, it is not at all clear from the sketches at issue in this case that the concept was any different in the designer's mind. The design sketches are clearly of cheerleading uniforms, conceived as worn by cheerleaders. Although it may be true that the production department did not instruct the designers not to include a certain chevron or stripe combination because the realities of fabric production would not allow it, it also appears to be true that the designers were at all times conceiving of and sketching various designs of cheerleading uniforms.

Put another way, a cheerleading uniform loses its utilitarian function as a cheerleading uniform when it lacks all design and is merely a blank canvas. An examination of the blank cheerleading silhouettes that Varsity submitted illustrates this point. (*See* Pg. ID # 2825–26.) Without the kind of ornamentation familiar to sports (or cheerleading) fans, the silhouette no longer evokes the utilitarian concept of a cheerleading uniform, a garment that is worn by a certain group of people in a specific

context. (*See, for example*, Pg. ID # 2814–18.) Varsity argues that a blank cheerleading silhouette "covers the body to the same degree, wicks away moisture, and withstands the rigors of cheerleading movements at least as much as, if not more than, a garment that has a design on the front of it." (Pg. ID # 2342.) This statement may be true, but it ignores the fact that the utilitarian function of a cheerleading uniform is not merely to clothe the body; it is to clothe the body in a way that evokes the concept of cheerleading. Artistic judgment and design are undeniably important in this context, but they are not separable from the utilitarian function of the resulting garment.

For this reason, *Universal Furniture* is distinguishable. The designs at issue in *Universal Furniture* were carvings on pieces of furniture. As the Fourth Circuit noted, the designs were "wholly unnecessary" to the furniture's utilitarian function. *Universal Furniture*, 618 F.3d at 434. A desk without carved designs on it, although perhaps less aesthetically pleasing, is still a desk. As such, it still serves its utilitarian function and is separate conceptually from the carved designs themselves. In contrast, a blank silhouette of a purported "cheerleading uniform" without team colors, stripes, chevrons, and similar designs typically associated with sports in general, and cheerleading in particular, is not recognizable as a cheerleading uniform. It evokes an entirely different concept in the viewer's mind. This is because, as a matter of law, the design of cheerleading uniforms has merged with the utilitarian function they serve. And under the Fifth Circuit's marketability test in *Galiano*, it is unlikely that the designs in this case would be marketable outside of

their utilitarian function as cheerleading uniforms. *Galiano*, 416 F.3d at 419–21.

Attempting to physically separate the cheerleading designs further underscores this concept. In addition to posing the type of "metaphysical quandary" of free floating "designs in space" identified in *Universal Furniture*, removing the lines, patterns, and chevrons from the actual physical garments at issue in this litigation and placing them on a different canvas does not remove their association as cheerleading uniforms. *See Universal Furniture*, 618 F.3d at 434. A sample fabric displaying sublimated designs illustrates this point. Despite showing the design physically separated from a utilitarian cheerleading uniform, the fabric evokes the image and concept of a cheerleading uniform and proves the difficulty of removing the design from the utilitarian article. (*Compare* Pg. ID # 2820–23, *with* Pg. ID # 2825–26.) In short, the concept remains the same, even if the medium changes.

Because the court concludes as a matter of law that it is not possible to either physically or conceptually sever Varsity's designs from the utilitarian function of the resulting cheerleading uniforms, the court grants Star's motion for summary judgment on each of Varsity's copyright infringement claims, counts I–V of the complaint. (Pg. ID # 6–10.) The court denies Varsity's motion for summary judgment as to the same.[5]

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[5] Varsity also moved for summary judgment on Star's counterclaims of fraud on the Copyright Office and copyright misuse. However, despite being cast as "counterclaims" it appears that they are more accurately described as "affirmative

[Footnote continued on next page]

C. Trademark Infringement (Count X)

Varsity originally brought a claim under the Lanham Act based on the naming conventions and style codes initially adopted and used in Star's 2010 catalog. Star moved for summary judgment on this claim and in its responsive motion, Varsity indicates that it does not oppose Star's motion for summary judgment. (Pg. ID # 2360.) Therefore, summary judgment is granted to Star on count X of Varsity's complaint.

D. State Law Claims (Counts VI–IX, XI)

Star also moves for summary judgment on Varsity's state-law claims of unfair competition, inducing breach of contract, inducing breach of fiduciary duty, and civil conspiracy. As discussed above, the court grants summary judgment to Star on Varsity's copyright infringement claims, as well as on Varsity's trademark infringement claim, leaving only state-law claims pending before the court. "When all federal claims are dismissed before trial, the balance of considerations usually will point to dismissing the state law claims." *Musson Theatrical, Inc. v. Fed. Express Corp.*, 89 F.3d 1244, 1254–55

[Footnote continued from previous page]
defenses." *See, for example, Microsoft Corp v. Compusource Distributors, Inc.*, 115 F. Supp. 2d 800, 810 (E.D. Mich. 2000) (Borman, J.) (characterizing copyright misuse as a defense to copyright infringement); *Lasercomb America, Inc. v. Reynolds*, 911 F.2d 970, 972 (4th Cir. 1990) (same); *Tacori Enters. v. Rego Mfg.*, No. 1:05cv2241, 2008 WL 4426343, at *14 (N.D. Ohio Sept. 25, 2008) (characterizing fraud on the copyright office as an affirmative defense). Because the court grants summary judgment to Star on other grounds, it is not necessary to address the merit of these affirmative defenses.

(6th Cir. 1996); 28 U.S.C. § 1367(c)(3). ("The district court[] may decline to exercise supplemental jurisdiction over a claim . if the district court has dismissed all claims over which it has original jurisdiction."). Because the state-law issues raised in the remaining claims are better addressed in state court, the court dismisses counts VI–IX, and XI without prejudice.

III. CONCLUSION

Accordingly,

IT IS ORDERED that Defendants' motion for summary judgment [Dkt. # 169] is GRANTED IN PART and DENIED IN PART. Summary judgment is GRANTED IN PART to Defendant on Plaintiffs' copyright claims (counts I–V) and trademark infringement claim (count X). Summary judgment is DENIED IN PART in that the court declines to exercise supplemental jurisdiction over Plaintiffs' remaining state-law claims (counts VI–IX, and XI). These claims are DISMISSED WITHOUT PREJUDICE.

IT IS FURTHER ORDERED that Varsity's motion for summary judgment [Dkt. # 172] is DENIED.

A separate judgment will issue.

s/Robert H. Cleland
ROBERT H. CLELAND
UNITED STATES DISTRICT JUDGE

Dated: March 1, 2014

I hereby certify that a copy of the foregoing document was mailed to counsel of record on this date, March 1, 2014, by electronic and/or ordinary mail.

s/Lisa Wagner
Case Manager and Deputy Clerk
(313) 234-5522

No. 14-5237

UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

VARSITY BRANDS INC., ET AL.,	)	FILED
Plaintiffs-Appellants,	)	Oct 07, 2015
	)	DEBORAH
v.	)	S. HUNT,
STAR ATHLETICA, LLC,	)	Clerk
	)	
Defendant-Appellee.	)	ORDER
	)	

BEFORE: GUY, MOORE, and McKEAGUE, Circuit Judges.

The court received a petition for rehearing en banc. The original panel has reviewed the petition for rehearing and concludes that the issues raised in the petition were fully considered upon the original submission and decision of the case. The petition then was circulated to the full* court. No judge has requested a vote on the suggestion for rehearing en banc.

Therefore, the petition is denied. Judge McKeague would grant rehearing for the reasons stated in his dissent.

ENTERED BY ORDER OF THE COURT

Deborah S. Hunt, Clerk

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* Judge Donald recused herself from participation in this ruling.